FILE COPY

AUG 21 1972

IN THE

Supreme Court of the United States

MICHAEL ROBAK, JR., CLERK

October Term, 1972

No. 72-294

L. GOLDSTEIN'S SONS, INC.,
Petitioner

v.

TRIO PROCESS CORPORATION,
Respondent

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

HERBERT A. FOGEL
DAVID F. MAXWELL
OBERMAYER, REBMANN, MAXWELL & HIPPEL
14th Floor, Packard Building
Philadelphia, Pennsylvania 19102

NELSON E. KIMMELMAN
1407 Lewis Tower Building
Philadelphia, Pennsylvania 19102
Attorneys for Petitioner,
L. Goldstein's Sons, Inc.

THE LEGAL INTELLIGENCER, 66 NORTH JUNIPER STREET, PHILA., PA. 19107

INDEX TO PETITION

	Page
A. Opinions Below	2
B. Jurisdiction	2
C. Questions Involved	3
D. Statutes and Regulations Involved	5
E. Statement of the Case	8
F. Reasons for Granting the Writ	11
1. There is a split of authority among the various circuits as to whether a patentee may assert against an infringer a broadened interpretation of patent claims which have been narrowed in response to a rejection by the patent office on grounds *other* than prior art	11
a. Circuits in accord with the Third Circuit	12
b. Circuits holding contra the Third Circuit	13
c. A Supreme Court clarification of the bases, metes and bounds of the file wrapper estoppel doctrine is highly desirable	16
2. The Court of Appeals erred in applying the presumption of validity so rigorously in the light of the Supreme Court's pronouncement in *Graham v. John Deere* and the case law	17
3. The Court of Appeals did not apply the proper test for determining the patentability of a combination of known process steps	19

INDEX TO PETITION *(Continued)*

Page

4. A patentee who consciously conceals certain facts and misrepresents others contrary to 35 *U.S.C. 112* should have his patent invalidated even if such facts do not relate to utility, novelty or obviousness 20

5. Acts specifically held legal by this Court should not be used to justify the invocation of the exceptional penal provisions of 35 U.S.C. 284 relating to willful infringement . 21

G. Conclusion 23

INDEX TO THE APPENDIX

Opinion and Order of the United States District Court 1a

Opinion and Judgment of the United States Court of Appeals 15a

Sur Petition for Rehearing 31a

TABLE OF CITATIONS

Cases:

Anderson's Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57; 90 S. Ct. 305 (1969) 19

Besley-Welles Corporation et al. v. Balax, Inc., 291 F.2d 328; 160 USPQ 265 (E.D. Wisc. 1968) ... 21

Bishman Mfg. Co. v. Stuart-Warner Corp., 380 F.2d 336 (C.A. 7), *cert. denied*, 389 U.S. 897 (1967); 153 USPQ 496 11

TABLE OF CITATIONS—*(Continued)*

Cases: Page

Blonder-Tongue Laboratories, Inc. v. Univ. of Illinois Foundation, 402 U.S. 313; 169 USPQ 513 (1971) 16

Borg Warner Corp. v. Paragon Gear Works, Inc. 355 F.2d 400; 148 USPQ 1 (C.A. 1, 1966) 13

Deepsouth Packing Co., Inc. v. The Laitram Corporation, — U.S. — (1972) 40 U.S. Law Week 4575 (May 30, 1972) 22

Exhibit Supply Co. v. Ace Products Corp., 315 U.S. 126; 52 USPQ 275 (1942) 3

Graham v. John Deere Company, 383 U.S. 1 (1966) .. 17

Keating v. Stearnes Imperila Co., 347 F.2d 444; 146 USPQ 148 (C.A. 7, 1965) 15

The Laitram Corp. v. Deepsouth Packing Co., Inc., 443 F.2d 928; 172 USPQ 190 (Aff'g. 162 USPQ 14) (C.A. 5, 1971) 14

L.B. Smith v. Hughes, 190 F. Supp. 787, 797 (E.D. Pa. 1961) Affirmed 296 F.2d 738 18

Lemelson v. DeLuxe Reading Corp., 321 F. Supp. 1281; 168 USPQ 636 (D.C.S.N.Y., 1970) 12

Matherson-Selig Co. v. Carl Gorr Color Card, Inc., 154 USPQ 265 (D.C. Ill., 1966) 12

Maxon Pre-Mix Burner Co. v. Mid-Continent Metal Prods. Co., 270 F. Supp. 164 (N.D. Ill. 1967) .. 22, 23

McCullough Tool Co. v. Well Surveys Inc., 343 F.2d 381; 145 USPQ 6 (C.A. 10, 1965) 12

Monsanto Co. v. Rohm and Haas Co., 312 F. Supp. 778; 164 USPQ 556 (E.D. Pa. 1970); affirmed — F.2d — (C.A. 3, 1972) 165 USPQ 683; *cert. den.* 170 USPQ 199 21

TABLE OF CITATIONS—*(Continued)*

Cases: Page

Moon v. Cabot Shops, Inc., 270 F.2d 539; 123 USPQ 60 (C.A. 9, 1959) *cert. den.* 361 U.S. 965 15

Norvell v. McGraw Edison Co., 316 F. Supp. 198, 167 USPQ 47 (D.C.E.D. Wis. 1970) 18

Norwood v. Ehrenreich Photo-Optical Industries, Inc. et al., 322 F. Supp. 898; 168 USPQ 72 (D.C.C.D. Cal. 1971) 15

Parke-Davis and Co. v. American Cyanamid, 207 F.2d 571 (C.A. 6, 1953) 14

Powder Power Tool Corp. v. Powder Actuated Tool Co. 230 F.2d 409; 108 USPQ 155 (C.A. 7, 1956) . 11

Power Curbers, Inc. v. E.D. Etnyre & Co., 298 F.2d 484; 132 USPQ 158 (C.A. 4, 1962) 13

Sears, Roebuck & Co. v. Stiffel, 376 U.S. 225 22

Upjohn Company v. Italian Drugs Importing Co., 190 F. Supp. 361, 128 USPQ 236 (S.D.N.Y. 1961) ... 21

United States v. Adams, 383 U.S. 39 (1966) 19

Code:

35 U.S.C. §101 5

35 U.S.C. §102 5

35 U.S.C. §103 5

35 U.S.C. §112 5

35 U.S.C. §132 6

35 U.S.C. §282 6

35 U.S.C. §284 7

35 U.S.C. §285 7

Rules and Regulations:

Rule 75(d)(1) of the U.S. Patent Office 7

IN THE

Supreme Court of the United States

October Term, 1972

No. ———

L. Goldstein's, Inc., *Petitioner*

v.

Trio Process Corporation, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

L. Goldstein's, Inc. petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Third Circuit entered in the above case on May 22, 1972.

A. OPINIONS BELOW

The opinion of the Court of Appeals [App. 15a][1] is reported at 174 USPQ 139. The opinion of the United States District Court for the Eastern District of Pennsylvania [App. 1a] is reported at—F.Supp.—(1971).

B. JURISDICTION

The judgment of the Court of Appelas [App. 30a] was entered on May 22, 1972. A timely petition for rehearing was denied on July 5, 1972 [App. 31a]. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

1. References to the appendix pages of this Petition are designated "App.".

C. QUESTIONS INVOLVED

Respondent's assignor devised a method and apparatus for burning off the insulation from scrap copper wire of which petitioner became aware. Upon consulting its patent counsel petitioner was advised that the invention was not patentable.

Meanwhile, the inventor had filed a patent application and unsuccessfully presented successively narrower versions of the original claims to the Patent Office. In the third amendment, the inventor sought to change the wording of the main method claims so as to make them also applicable to *petitioner's* process. The Patent Office rejected this attempt to broaden the scope of the invention as set forth in the original disclosure because it had no antecedent or basis in the application originally filed. In reply, the inventor, *without any argument*, amended these method claims to restore their original, more restricted wording. The Patent Office then allowed these narrowed claims.

After the patent issued the respondent sued petitioner alleging that petitioner's process infringed the patent assigned to it. Petitioner, however, used the very inverted sequence of process steps which the patentee had unsuccessfully tried to claim when his patent was pending. The Court of Appeals held that respondent was *not* estopped by the Patent Office record* from asserting that those narrowed claims did cover petitioner's process since those claims were *not* narrowed in response to *prior art* rejections.

Whereas the District Court had held the patent invalid because of prior art not known or considered by the Patent Office, the Court of Appeals reversed saying that the District Court misapplied the law.

The Court of Appeals sustained the District Court's finding of willful infringement despite petitioner's having received an opinion of prospective patent invalidity from

---

*This is known as "file wrapper estoppel" *Exhibit Supply Co. v. Ace Products Corp.*, 315 U.S. 126; 52 USPQ 275 (1942).

its patent attorney. The District Court based its finding of willfulness, in part, on conduct of the petitioner adjudicated legal in *Deepsouth Packing Co., Inc. v. The Laitram Corporation*, 40 U.S. Law Week 4575 (May 30, 1972). Therefore the questions presented are:

I. Was it proper to find petitioner guilty of infringement based on a broadened interpretation of the claims of respondent's patent when the Patent Office had refused to permit the patentee to correspondingly broaden the patent claims before it issued?

The resolution of this question necessarily involves a consideration of the question of the correctness of the limitation of the doctrine of file wrapper estoppel solely to cases where patent claims are restricted in scope because of Patent Office rejections based on prior art. This question has hopelessly divided the various Courts of Appeal in the last 10 years.

II. Did the Court of Appeals accord the patent in issue undue presumptive validity under 35 U.S.C. 282 and apply the proper evidentiary test ("Clear and convincing" proof) in the light of the Supreme Court's own pronouncement in *Graham v. John Deere Company*, 383 U.S. 1 (1966)?

III. Did the Court of Appeals err in applying the correct test for determining the patentability of an invention involving a combination of known process steps as set forth in *Anderson's Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)?

IV. If a patentee consciously conceals certain facts and misrepresents others contrary to the requirements of 35 U.S.C. 112, can his patent be invalidated even if those facts do *not* relate to utility (35 U.S.C. 101), novelty (35 U.S.C. 102) or obviousness (35 U.S.C. 103)?

V. Can acts specifically held legal by this Court* be used to justify the invocation of the exceptional penal provisions of 35 U.S.C. 284 relating to willful infringement?

---

* *Deepsouth Packing Co., supra.*

D. STATUTES AND REGULATIONS INVOLVED

35 *U.S.C. 101*. Inventions Patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 *U.S.C. 102*. Conditions for Patentability; Novelty and Loss of Right to Patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * *

35 *U.S.C. 103*. Conditions for Patentability; Non-Obvious Subject Matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 *U.S.C. 112*. Specification.

The specification shall contain a written description of the invention, and of the manner and process of making

and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

* * *

35 *U.S.C. 132.* Notice of Rejection; Reexamination.

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. *No amendment shall introduce new matter into the disclosure of the invention.* [Emphasis added]

35 *U.S.C.* 282. Presumption of Validity; Defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability.

* * *

35 *U.S.C.* 284. Damages.

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

* * *

35 *U.S.C.* 285. Attorney Fees.

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

Rule 75 of the U.S. Patent Office. Claim(s).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

* * *

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the *terms and phrases used in the claims must find clear support or antecedent basis in the description* so that the meaning of the terms in the claims may be ascertainable by reference to the description. [Emphasis added]

* * *

E. STATEMENT OF THE CASE

Respondent sued petitioner alleging infringement of respondent's U.S. Patent 3,076,421, unfair competition and violation of 15 U.S.C. Sec. 2. This patent contained three claims which relate to a method of burning off the insulation and other organic material surrounding metallic wire scrap, ostensibly without oxidizing or embrittling the wire content. The petitioner answered with defenses of patent invalidity and non-infringement.

In the trial of the action, it was brought out that patentee had originally presented one method claim and four claims addressed to a portable incinerator, but that these had all been rejected as being too broad in view of prior art. In the two and one half years following the filing date of the patent application, the patentee presented eight additional claims, all of which had also been rejected by the Patent Office.

The patent application as filed covered a process whose principal steps were as follows:

1. Igniting a pile of scrap wire.
2. Superimposing an incinerator over the ignited pile.
3. Limiting the air input to the ignited pile to keep its temperature low so as not to melt the wire.
4. Passing the products of this low temperature combustion (smoke and gases) to a much higher temperature afterburner to oxidize those combustion products.

During the pendency of the application, 50% more textual descriptive material was added to provide support for the added claims, which included proposed claims 14-17. As presented by patentee's third amendment,* these claims 14-17 were so worded as to cover both the *disclosed* method

*No claim had been allowed to this date, Sept. 8, 1960, which was two years after the application had been filed.

summarized above and also a method in which steps 1 and 2 were reversed. As a matter of fact, this inverted order had been developed by the petitioner who found it was far superior to the order of steps disclosed by the patentee. By lighting the scrap pile after the incinerator had *already* been superimposed, there was not a great rush of air into the pile which would cause unwanted smoke to initially appear in the output of the incinerator so as to pollute the environment. When the Patent Examiner examined proposed claims 14-17 he detected this transparent attempt to broaden the scope of the invention. He thereupon rejected them as not having "antecedent basis in the description." The Examiner cited Rule 75(d)(1) and had apparently concluded that the patentee was attempting to circumvent the provisions of 35 U.S.C. 132 which states, in part:

> "* * * No amendment shall introduce new matter into the disclosure of the invention.* * *"

35 U.S.C. 112 further provides that the claims shall particularly point out and distinctly claim the subject matter which the applicant regards as his invention. In response to this rejection, the patentee took an appeal on October 2, 1961. At the same time, he filed a proposed amendment to claims 14-17 which *restored* the original order of steps 1 and 2 of the process summarized above. [App. 4a] In that amendment he did *not* traverse the Examiner's rejection of the claims 14-17 in their original form. After a further interview with the Examiner, and further changes to claims 14-17, the patentee dropped his appeal. He was thereupon granted claims 14-17 revised to recite the *original* order of steps 1 and 2.

In the action brought by respondent against petitioner, the trial court specifically found that the patent covered the *original* order of steps 1 and 2 (above) whereas petitioner's process, to the contrary, used the *inverted* order which the inventor unsuccessfully sought to cover by his proposed claims 14-17 [App. 10a]. Nevertheless, the

courts below did *not* say that the patentee was estopped by the proceedings in the Patent Office (file wrapper estoppel) from reasserting that his claims *also* covered the inverted order actually practiced by petitioner.

Although the trial court had found the patent invalid because of a number of technical articles which were not considered or known to the Patent Office, the Court of Appeals nevertheless reversed, applying the test of "clear and convincing proof" as the standard necessary to overturn the Patent Office grant.

The Court of Appeals ignored the prior art installation of American Smelting and Refining Company [App. 2a] and gave scant attention to the additional patents and literature references cited by petitioner [App. 5a, Findings of Fact 23-28] finding them to be "merely cumulative to the references before the Examiner." [App. 24a] The opinion of the Court erroneously stated that the chief point of novelty in respondent's process was the fact that organically-coated metal was burned at low temperature [App. 17a, 24a].

The Court of Appeals also held petitioner to be a willful infringer since it had only sought the advice of patent counsel* *before* the patent issued, not after. The Court also seemed to say [App. 30a] that when petitioner sent blueprints of the unpatented incinerator and operating instructions for it to a foreign country where respondent had no patent rights, this was somehow reprehensible even though such acts are specifically stated not to be violative of any law by the decision of the Supreme Court in *Deepsouth Packing Company, supra.*

---

* Patent counsel is a well-known attorney and patent law authority who has published a number of treatises and articles which have been cited in at least two cases before the U.S. Supreme Court and in several other Federal cases.

F. REASONS FOR GRANTING THE WRIT

1. There is a split of authority among the various circuits as to whether a patentee may assert against an infringer a broadened interpretation of patent claims which have been narrowed in response a rejection by the patent office on grounds *other* than prior art.

In the opinion of the Court of Appeals below [App. 29a], the Court acknowledged that respondent's earliest versions of proposed method claims 14-17 attemped to invert the order of steps 1 and 2 of the patented process, but had to be amended (narrowed) to gain the grant of the patent. The Court states [App. 29a] that respondent *could* recapture the attempted broadened scope of proposed claims 14-17 because the patentee had not surrendered the broader scope in response to a rejection by the Patent Office on prior art, citing *Bishman Mfg. Co. v. Stuart-Warner Corp.*, 380 F.2d 336 (C.A. 7), *Cert. denied*, 389 US 897 (1967); 153 USPQ 496. However, that decision in the Court of Appeals for the Seventh Circuit nowhere states that for file wrapper estoppel to apply it is necessary, at the least, that a claim have been narrowed to avoid the prior art.

As a matter of fact, the *Bishman* case did *not* overrule or in anyway attempt to distinguish from the earlier Seventh Circuit case of *Powder Power Tool Corp. v. Powder Actuated Tool Co.*, 230 F.2d 409; 108 USPQ 155 (C.A. 7 1956). In the latter case, during the pendency of the application in the U.S. Patent Office, the Patent Office rejected claims 18-20 as being "aggregative and indefinite," *not* because of any prior patent or art. In response to this rejection the applicant cancelled them and substituted two other narrower claims which were finally allowed by the Patent Office. The patentee then sued an alleged infringer and

sought to extend the scope of these allowed claims to cover the alleged infringing article. In finding for the alleged infringer, the Court *did* apply the doctrine of "file wrapper estoppel."

The decision of the Court below seems to be the first definitive holding in the Third Circuit that the doctrine of file wrapper estoppel is limited *solely* to cases where claims were modified because of cited prior art.

a. Circuits in accord with the Third Circuit.

The Eighth and Tenth Circuits appear to be in accord with the Third Circuit. *Matherson-Selig Co. v. Carl Gorr Color Guard, Inc.*, 154 USPQ 265 (D.C. Ill. 1966)*; *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381; 145 USPQ 6 (C.A. 10 1965).** In the Second Circuit in the case of *Lemelson v. DeLuxe Reading Corp.*, 321 F.Supp. 1281; 168 USPQ 636 (D.C.S.N.Y., 1970), the holding is not clear since the original claims were rejected on *two* grounds (1) inadequate disclosure and (2) prior art patents. When the patentee narrowed them, got his patent, and then sued for infringement of these narrowed claims, he contended that their scope nonetheless included previously cancelled features. The Court invoked the doctrine of file wrapper estoppel and refused to allow this broadened interpretation. Certainly this holding does not unequivocal-

---

* The Court's authorities in that case are the *Exhibit Supply case, supra*, the *Graham v. Deere case, supra*, and two Seventh Circuit cases, none of which specifically hold that file wrapper estoppel applies *only* in case of prior art rejections. As a matter of fact, the Seventh Circuit, as will be seen below, holds to the contrary.

** However, in the *Norwood* case, infra, the Court of Appeals of the Tenth Circuit held the estoppel doctrine applicable where the patentee restricted his claims in response to a rejection on "double patenting" (i.e., because it covered the same invention as another one of his patents) rather than to a rejection based on prior art.

ly declare that file wrapper estoppel applies *only* in cases where claim limitations are inserted in response to *prior art* rejections.

b. Circuits holding contra the Third Circuit.

It would be well to examine cases in which numerous Courts of Appeal have held file wrapper estoppel applicable in cases *other than* those in which the applicant has limited his claims in response to rejections based upon *prior art*.

The **First Circuit** has stated that it does not really matter whether the limitations are inserted because of prior art rejections or because the Patent Office insists on claim changes to conform to the description in the patent application. The test, the Court said, is to find out exactly what, if anything, the patentee surrendered when he limited his claim. The Court said:

> "We think of no reason, and find none suggested in the cases, why the importance and materiality of language in a claim depend upon the particular objection the Patent Office had voiced. *A patent may be just as invalid because the description is inadequate* as it may be because of the prior art.*** If an applicant who accedes to a demand based on the prior art is thereafter estopped to contest its necessity, *he should equally be estopped to deny the correctness of a demand for which some other reason is given* [emphasis added].*** " *Borg Warner Corp. v. Paragon Gear Works, Inc.*, 355 F.2d 400; 148 USPQ 1 (C.A. 1, 1966).

In the **Fourth Circuit** in the case of *Power Curbers, Inc. v. E. D. Etnyre & Co.*, 298 F.2d 484; 132 USPQ 158 (C.A. 4, 1962). In that case, the Patent Office had rejected a number of the patentee's original claims for indefiniteness or prior art patents. When the patentee narrowed these claims and attempted to assert the original broader scope against an alleged infringer the Court applied the

file wrapper estoppel doctrine against the patentee stating that he had voluntarily acquiesced in the correctness of the rejection.

In the **Fifth Circuit** there is an explicit holding by the Court of Appeals as follows:

> " * * * we agree with the trial court's legal conclusion that the doctrine of file wrapper estoppel properly applies to all Patent Office surrenders, *not merely to those which are based on prior art* * * * " [Emphasis added]

The Laitram Corp. v. Deepsouth Packing Co., Inc., 443 F.2d 928; 172 USPQ 190 (Aff'g. 162 USPQ 14) (C.A. 5 1971).

In the **Sixth Circuit** there is a case involving an anti-anemia pharmacological product. *Parke Davis and Co. v. American Cyanamid*, 207 F.2d 571 (C.A. 6 1953). The patentees' original claims were rejected for failing "to define the product properly." They were amended three subsequent times and were rejected three subsequent times, the last rejection being based on the wording of a clause inserted by the patentee stating that a certain constituent of the product was "derivable by autolysis from mammalian liver tissue." The Patent Office rejected this proposed insertion too and insisted that "derivable" be changed to "derived" to conform to the original disclosure.* In response to this rejection the patentee did change "derivable" to "derived." The patentee sued an infringer and sought to stretch the coverage of these so-amended claims. He contended that they covered the competing product of the defendant whose corresponding constituent was synthetic and *not* made from animal sources. The lower Court had held on *summary judgment* proceedings that the patentee was estopped to deny the limiting language in the claims as allowed since it had been adopted to avoid the Patent Of-

---

* Just as in the present case.

fice grounds of rejection. The Court of Appeals upheld the District Court on this point.

In the **Seventh Circuit** case of *Keating v. Stearnes Imperial Co.*, 347 F.2d 444; 146 USPQ 118 (C.A. 7 1965) the Court of Appeals upheld a summary judgment against the patentee which found the patent not infringed because of file wrapper estoppel. The patentee, during the course of the pendency of his application in the Patent Office had *voluntarily* restricted his claims to narrower language.

In the **Ninth Circuit** in *Moon v. Cabot*, 270 F.2d 539; 123 USPQ 60 (C.A. 9, 1959) cert. den. 361 U.S. 965, the Patent Office objected to the wording of four proposed claims as being inaccurate for not conforming to the specification.* The Examiner indicated that they would be allowed on change of wording to conform to the specification and the patentee acquiesced. Then the patentee sought to reassert the original scope of these narrowed claims against the alleged infringer, but the Court of Appeals struck down this attempt saying that he was estopped to enlarge them by resort to the doctrine of equivalents.

In the **Tenth Circuit** there is at least one recent case which applied the doctrine of file wrapper estoppel even though the patentee's restriction of his claims was *not* made in response to a rejection because of prior art, i.e., patents issued to *others*. *Norwood v. Ehrenreich Photo-Optical Industries, Inc., et al.*, 322 F.Supp. 898; 168 USPQ 72 (D.C. C.D. Cal. 1971). In that case, the Patent Office had rejected earlier broader claims because they were deemed to cover the same invention previously patented by the same patentee ("double patenting"). The patentee responded by cancelling these claims and substituting much more limited versions. After the Patent Office allowed these limited claims, the patentee sought to assert that they had a scope similar to the cancelled versions, but the Court found for the alleged infringer citing the *Exhibit Supply Co.* case, *supra*.

---

* As in the present case.

c. A Supreme Court clarification of the bases metes and bounds of the file wrapper estoppel doctrine is highly desirable.

The split of authority in the Circuits as to the applicability of the doctrine of file wrapper estoppel makes for legal non-uniformity and uncertainty throughout the United States. This is an undesired and unhealthy state of affairs since businessmen cannot intelligently plan or assess the risk of patent infringement liability before marketing or using a new product or process. If the patent in question has not yet been adjudicated the businessman's study of its Patent Office file history does not yield definite answers as to the effect of a patentee's restriction of claims in response to an Examiner's objection or rejection. But even if the patent has already been adjudicated in one circuit, which has held file wrapper estoppel to be applicable so that the businessman's product does *not* infringe in one circuit, there is nothing to prevent another circuit with more stringent file wrapper estoppel rules from holding it to *be* an infringement there.

The possibility of forum-shopping is much more possible in patent cases than in most other types of litigation since acts of infringement may consist of making, using or selling (35 U.S.C. 271) the accused device. The patentee therefore usually has a choice of forums provided he meets appropriate venue requirements. Venue depends on the type of defendant, which party institutes the suit, and where the alleged infringer resides or has a regular place of business.* A prudent patentee, mindful of the fact that his infringement suit may result in a complete loss of all his patent rights in case of a holding of invalidity,** will be very care-

---

* See the special patent venue provisions of 28 U.S.C. 1400(b), the declaratory judgment venue provisions of 28 U.S.C. 1391(c), and the special alien venue provisions of 28 U.S.C. 1391(d).

** *Blonder-Tongue Laboratories, Inc. v. Univ. of Illinois Foundation*, 402 U.S. 313; 169 USPQ 313 (1971).

ful to choose a forum such as the Third Circuit which severely restricts the file wrapper estoppel doctrine to prior art. A potential infringer will, conversely, seek a forum such as the Fifth Circuit where the doctrine is much more liberally applied. Such forum-shopping is against the public interest and should be decisively discouraged wherever possible, as this Court did in ruling that collateral estoppel should apply to an adjudication of a patent's invalidity. *Blonder-Tongue, supra.*

2. The Court of Appeals erred in applying the presumption of validity so rigorously in the light of the Supreme Court's pronouncement in *Graham v. John Deere* and the case law.

The Third Circuit Court of Appeals in its opinion [App. 20a] stated that the invalidity of a patent "must be demonstrated by clear and convincing proof citing, among other cases, *Moon v. Cabot Shops, Inc., infra.* This judicial construction is, of course, grounded upon 35 *U.S.C.* 282. It is a very strong presumption but considerable doubt has been cast upon it in the Supreme Court case of *Graham v. John Deere Co.* in which the Court stated at page 18:

> "We have observed a notorious difference between the standards applied by the Patent Office and by the Courts. While many reasons can be adduced to explain this discrepancy, one may well be the free-rein often exercised by Examiners in their use of the concept of 'invention.' In this connection we note that the Patent Office is confronted with a most difficult task. Almost 100,000 applications for patents are filed each year. Of these, about 50,000 are granted with a resultant backlog now running well over 200,000."

From this recent pronouncement, it would seem that the present validity of the "clear and convincing" standard is highly questionable.

Even if the Supreme Court itself had not cast a pall on the presumption, it has been settled law for many years that a presumption of validity is considerably weakened "to the extent that the Examiner has not considered the most relevant aspects of prior art relied on by the alleged infringer." *L. B. Smith v. Hughes*, 190 F.Supp. 787, 797 (E.D. Pa. 1961) Affirmed 296 F.2d 738; *Norvel v. McGraw Edison Co.*, 316 F.Supp. 198, 167 USPQ 47 (D.C.E.D. Wisc. 1970). In the present case, the Court of Appeals found [App. 23a] that the trial court had relied on five of the seven patents considered by the Patent Office, four of the additional patents not before the Patent Office, and the three literature references. Although the Court erroneously indicated [App. 24a] that the prior art did not show low-temperature burning of the insulation from wire scrap, it did not even mention, let alone consider, the scrap copper wire reclamation procedures of the American Smelting and Refining Co. mentioned in the trial court's Findings of Fact [App. 2a]. This finding acknowledges that there was, before the present invention, a commercial wire reclamation process including a second-stage after-burner chamber for burning insulation off of wire. The trial record clearly revealed that the primary combustion chamber was a low-temperature burning chamber since the amount of air to it was limited. Nor did the Court of Appeals correctly state the substance of the literature reference Exhibit D-24 [App. 9a] which is specifically intended for burning insulation off of electrical scrap metal items.

In view of the *Graham v. Deere* dictum and the omission by the Court of Appeals to consider adequately and understand properly the art cited by the petitioner, this Court is solicited to make a fresh inquiry as to the vitality and application of the rules and decisions concerning the presumptive validity of patents.

3. The Court of Appeals did not apply the proper test for determining the patentability of a combination of known process steps.

In the opinion of the Court of Appeals [App. 21a] there is a citation of *U.S. v. Adams*, 383 U.S. 39 (1966) to the effect that, for a combination of old elements or steps to be patentable they must not have been previously used together and must produce *unexpected* results, particularly where the prior art indicates that the procedure will be unproductive. The Court, citing *Anderson's Black Rock, supra*, recognized that the steps would have to be combined in an "unsuggested manner into a process that would achieve a substantially different function and result from the other processes of which the individual stages were a part" [App. 25a]. However, the Court did not analyze, as the trial court did, the prior art to show that the steps had *not* previously been used together. As a matter of fact, the prior art *did* show the steps used together but not in a portable apparatus. Nor did the Court show how the combination produced an unexpected result or a synergistic one. The Court totally ignored significant prior art not considered by the Patent Office such as the American Smelting and Refining Co. installation [App. 2a, Finding of Fact 6] and Exhibit D-24 [App. 9a, Finding of Fact 26(a)] which specifically recites a method for burning insulation off of electrical scrap. It includes a low temperature primary combustion chamber and a subsequent high-temperature after burner chamber. The only difference in the process is that the patentee brings his incinerator to the scrap rather than vice versa. But this idea is hardly novel—the 1916 Middaugh patent "[App. 8a, Finding of Fact 24(c)] shows a portable incinerator that can be placed over scrap lumber piles for burning them. Since all of the steps

were well known and most of them had been used together in scrap metal reclamation and functioned in the same way as those of the present patent, i.e., (1) low-temperature incomplete combustion was followed by (2) high temperature after-burner oxidizing of the products of incomplete combustion, the non-obvious test was not properly applied.

4. A patentee who consciously conceals certain facts and misrepresents others contrary to *35 U.S.C. 112* should have his patent invalidated even if such facts do not relate to utility, novelty or obviousness.

Petitioner proved during the trial that the patentee deliberately withheld from the Patent Office the fact that his invention *would not work* with common aluminum wire, the fact that even copper wire was oxidized and embrittled despite claims to the contrary in the patent specification, and that conventional scrap wire processes had done a satisfactory job [App. 26a]. Petitioner argued that these misrepresentations should therefore invalidate the patent under the provisions of 35 *U.S.C. 112*. The Court of Appeals did not deny that the proofs showed these misrepresentations but stated that:

> ". . . they were not material, in that they did not relate to the statutory conditions of patentability: novelty 35 U.S.C. 102; obviousness, 35 U.S.C. 103; or utility," 35 U.S.C. 101 . . ." [App. 26a]

and hence dismissed petitioner's argument. The Court did not cite a *single* case standing for this proposition. A patent is a covenant between the patentee and the U.S. Government by which, in return for a *complete* disclosure of the invention, the patentee is granted a limited monop-

---

" Patentee's own admission that his invention would not work on aluminum wire certainly bears on *utility!* [App. 26a, n.22]

oly. As Judge Masterson held in *Monsanto Co. v. Rohm and Haas Co.*, 312 F. Supp. 778; 164 USPQ 556 (E.D.Pa. 1970); affirmed — F.2d — (C.A. 3, 1972) 165 USPQ 683; cert. den. 170 USPQ 199.

> ". . . The patent applicant should be held to the same standard of truthful disclosure to the Patent Office that Congress has required of the seller of securities to the public . . ."

There is no basis in law for the Court of Appeals' characterizing misrepresentations relating to 35 *U.S.C. 101, 102, 103* as being "material" and misrepresentations relating to 35 *U.S.C. 112* as being "immaterial." The Supreme Court should put to rest the idea of any such demarcation. If it does not, it may encourage patent applicants to risk misleading the Patent Office and the public in order to get a patent granted. The patent applicant might elect to run the risk since, even if his 35 *U.S.C. 112* misrepresentations of concealments were later detected, he would not suffer any possible penalty of invalidation by the application of the Court of Appeals' analysis.

5. Acts specifically held legal by this Court should not be used to justify the invocation of the exceptional penal provisions of 35 U.S.C. 284 relating to willful infringement.

"Willful infringement" is a penal provision of the patent statute to be invoked only in "exceptional circumstances." *Besly-Welles Corporation, et al. v. Balax, Inc.*, 291 F.2d 328; 160 USPQ 265 (E.D.Wisc. 1968); *Upjohn Company v. Italian Drugs Importing Co.*, 190 F. Supp. 361, 128 USPQ 236 (S.D.N.Y. 1961).

In the opinion of the Court of Appeals [App. 30a], the Court supported the finding by the district court of willful infringement by alluding to the fact that petitioner

sent blueprints of the respondent's incinerator abroad. When petitioner did these things it was doing what any U.S. citizen had the right to do.

Petitioner undoubtedly had the right, even in the U.S., to copy exactly the respondent's incinerator or publish its specification since the incinerator was in the public domain because it was *not patented. Sears, Roebuck & Co. v. Stiffel*, 376 U.S. 225. The incinerator was not patented in Belgium either and hence sending blueprints there was not a violation of foreign law which might be considered reprehensible conduct. Petitioner could have actually sent the complete incinerator to Belgium after having made it in the U.S. and no law would be broken, nor should any stigma attach thereto. *Deepsouth Packing Co., Inc. v. The Laitram Corporation*, — U.S. — (1972). Therefore there is insufficient legal basis to invoke the penal provisions of 35 U.S.C. 284 especially since petitioner had consulted well-known patent counsel before it had copies made of respondent's incinerator.

Patent counsel had advised that the incinerator and its main operating features were unpatentable, but if a patent did by chance issue it would be "invalid or . . . of very doubtful validity . . . unenforceable" [App. 3a] To avoid any trouble, however, petitoner took a license for two of those incinerators [App. 19a, Finding of Facts 11 and 12]. Later, petitioner refused to take a license for further incinerators, relying on the patent counsel's expert prognostication and advice. Patent counsel believed the incinerator system to be unpatentable and so did the trial court. These were certainly reasonable conclusions of reasonable men and petitioner was reasonable in relying on the pre-patent advice rather than seeking a later post-patent opinion on the same prior art facts.

This case is the *first* known one in which a court has required *two* opinions from counsel to a layman in order to avoid the imposition of treble damages. The case cited by the Court of Appeals in support of this proposition is *Maxon*

Pre-Mix Burner Co. v. Mid-Continent Metal Prods. Co., 270 F.Supp. 164 (N.D.Ill. 1967). But that case is not apposite; there the infringer did *not* even consult patent counsel *one* time. Furthermore, in *Maxon*, the defendant had *literally* infringed the patent claims; in the present case petitioner was found to infringe only by application of the doctrine of equivalents [App. 28a]. The Supreme Court should review the applicability of the statutory section 35 *U.S.C.* 284 in the light of the facts in this case and the authorities cited above.

G. Conclusion.

For the reasons set forth above, this petition should be granted.

Respectfully submitted,

HERBERT A. FOGEL
DAVID F. MAXWELL
OBERMAYER, REBMANN
MAXWELL & HIPPEL
14th Floor, Packard Bldg.
Philadelphia, Penna. 19102

NELSON E. KIMMELMAN
1407 Lewis Tower Bldg.
Philadelphia, Penna. 19102

APPENDIX

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Civil Action No. 38,166

TRIO PROCESS CORPORATION
and
FRANKLIN SMELTING AND REFINING COMPANY

v.

L. GOLDSTEIN'S SONS, INC.

OPINION

FINDINGS OF FACT AND CONCLUSIONS OF LAW

FULLAM, J. January 27, 1971.

This is a patent infringement and unfair competition action. The defendant contests the validity of the plaintiff's patent, and denies that it has infringed the plaintiff's patent. Pursuant to Fed. R. Civ. P. 42(b), the issues of liability for infringement and damages have been separated.

By way of background, the patent as issued is a process patent. However, as originally filed, the application contained both process and apparatus claims. The apparatus which was not covered by the patent as issued is comprised of a large conical furnace with a cylindrical afterburner section above the furnace. The furnace was designed to be used in commercial metal reclamation yards.

Upon review of the trial record, and consideration of the respective parties' proposed findings of fact and conclusions of law, the Court makes the following:

FINDINGS OF FACT

1. United States Patent No. 3,076,421 was issued on February 5, 1963 to Albert W. Spitz. Trio Process Corporation (hereinafter Trio) is now the rightful owner of the '421 patent.

2. Trio is a Pennsylvania corporation having its principal place of business at 437 N. Sterling Road, Elkins Park, Pennsylvania.

3. The Metal Bank of America, Inc. is a successor corporation to L. Goldstein's Sons, Inc., the named defendant, with its principal place of business at Knorr Street and Wissinoming Avenue, Philadelphia, Pennsylvania.

4. In October of 1957, the Franklin Smelting and Refining Company, of Philadelphia, Pennsylvania, engaged Mr. Albert W. Spitz as a consulting engineer. Mr. Spitz's first undertaking was to devise a method to improve Franklin's copper wire reclamation procedures.

5. At the time Mr. Spitz was engaged, wire reclamation through the medium of heat was primarily done by open burning or in fixed hearth furnaces.

6. During Mr. Spitz's research work, he viewed the copper reclamation procedures of the American Smelting and Refining Company of Perth Amboy, New Jersey. At American, a two-chamber refractory furnace was used in conjunction with an afterburner eight to fifteen feet down flue from the primary chambers.

7. The prototype of the apparatus currently used to carry out the plaintiff 's process was constructed between four to five months later. Franklin used the first workable furnace constructed by Mr. Spitz in its copper reclamation process in late 1958 or early 1959. The furnace was frustoconical in shape with a cylindrical afterburner section affixed to the lower section. The furnace was provided with an eye at the top to allow a crane to move the furnace about.

8. The defendant corporation engaged a consulting engineer in January of 1959 to improve its reclamation operations. At that time, the defendant knew of the Spitz

development and showed the Spitz furnace at Franklin to its consulting engineer. Although working concepts for two possible furnaces were developed by the consultant, neither was adopted by the defendant.

9. By July of 1959, the defendant was utilizing a chopping method to reclaim copper wire. A patent, No. 3,074,653, was issued to John Schorsch, vice-president of the defendant corporation, covering the apparatus used for this procedure.

10. In November of 1959, the defendant sought an opinion letter from a patent attorney relating to the patentability of the Spitz furnace. Mr. Schorsch provided the attorney with a diagram of the Spitz furnace. It was the attorney's opinion that the Spitz furnace was not patentable. Defendant did not seek an opinion of counsel as to the validity of the process patent after issuance.

11. By two written agreements of January 2, 1960, the defendant purchased a Spitz furnace and the license to use the furnace and the method for the duration of the life of the furnace, within a 30 mile radius of its principal place of business.

12. On May 12, 1960, the defendant purchased another Spitz furnace and acquired the license rights to use the second furnace and method, pursuant to the terms of the first license agreement.

13. In October of 1964, the defendant contracted with a metal fabricator for the construction of a copy of the Spitz furnaces which had been delivered to the defendant pursuant to purchase agreements with Trio.

14. The defendant acquired AMA Metal Corporation of Oceanside, New York, on February 1, 1965. At that time, AMA was a licensee of Trio and had purchased one furnace from Trio.

15. In March of 1965, the defendant ordered two more copies of the Spitz furnace, one of which was delivered to AMA. Thereafter the defendant contracted for the construction of six more furnaces to be built in essential conformity with the original furnaces delivered by Trio.

16. From 1960 to 1968, the defendant had secured clearances from the Department of Public Health of the City of Philadelphia to operate the furnances on its properties.

17. The prosecution of the '421 patent was initiated on October 29, 1958. The application contained five claims. On February 24, 1959, the examiner rejected apparatus claims 1, 3, 4 and 5 on the basis of prior art. Claim 2, a method claim, was rejected as an improper method claim and on the basis of prior art.

18. On August 25, 1959, claims 1 through 5 were withdrawn and claims 6 through 13 were added. On March 8, 1960, apparatus claims 6 through 9 were rejected on the basis of prior art. Method claims 10 through 13 were rejected as improper method claims because they relied on specific aspects of apparatus, and on the basis of prior art.

19. On September 8, 1960, claims 6 through 9 were amended, claims 10 through 13 were withdrawn, and claims 14 through 17 were added to replace claims 10 through 13. The examiner, on April 4, 1961, again rejected apparatus claims 6 through 9 due to prior art and on the basis that as amended they contained new matter. Method claims 14 through 17 were rejected as indefinite and misdescriptive. One basis for concluding claims 16 and 17 were misdescriptive was that they specified that the combustion chamber was superimposed over the scrap pile before ignition, whereas the original disclosure stated the scrap was to be ignited before superimposing the chamber over the scrap pile.

20. Amendments were filed October 2, 1961. However, on January 10, 1962, the amendments were found to be non-responsive to the examiner's rejection of April 4, 1961.

21. On January 15, 1962 claims 6 through 9, the apparatus claims, were withdrawn. An amendment was also made to claim 17. Further amendments were filed on March 16, 1962. Notice of allowance was mailed May 14, 1962, and the patent was issued February 5, 1963.

22. Patent '421 as issued contains claims 14 through 17 renumbered to be claims 1 through 4. At issue in this litigation are claims 1, 3 and 4. These claims are set out in the Appendix.

23. Of the seven patents cited by the examiner, the defendant relied upon the following at trial:

(a) The Morgan patent, Patent No. 1,082,644, was issued December 30, 1913. The inventor's purpose was to design a portable incinerator for the burning of tree stumps. The apparatus was comprised of a frusto-conical casing with an opening at the bottom to allow the burner to be placed over the stump, and having a conical top on the casing converging into a smoke stack. An opening and door were provided in the main body of the casing. A tube was also provided in the side of the casing to direct the air supply within the casing.

(b) The Lovelace patent, No. 266,850, issued October 31, 1882, related to the design of a portable charcoal kiln to be used in conjunction with a foundation constructed with a central fire chamber. Two passages were provided from the external side of the foundation through the foundation to the fire chamber with the opening at the exterior of the foundation equipped with a door and damper to control the amount of air reaching the fire chamber. The fire chamber was covered with a grate and solid door to prevent the fire from igniting the wood in the kiln. Flues were provided from the side of the fire chamber to the top of the foundation to allow the heat to reach the kiln area. Exit flues were provided from the top of the foundation downward and then outward to the exterior of the foundation to allow steam and smoke to be emitted. The hood which fit over the foundation was comprised of two steel hoods one-half inch apart. Ashes or other non-conductive material were to be used to prevent heat radiation and entry of air into the kiln. A door at the top of the hood was provided for placing wood into the kiln and a side door for taking the processed wood out. In the alternative, the hood could be merely placed over

the material and then removed after processing. The purposes of the patent were to prevent oxidation by allowing as little air as possible to enter the kiln area, and providing the necessary heat without direct contact of the wood with the fire source.

(c) The Breitweiser patent, No. 1,773,256, issued August 19, 1930, related to a device for deodorizing effluent gases of an incinerator. A cylindrical casing is to be fitted over an incinerator with the exit port of the incinerator coincident to the inlet port of the device. Adjacent to the inlet point of the device there is a burner adapted to direct a flame into the gases flowing up from the incinerator. An air intake port was provided to furnish air to the gases after they passed through the flames of the burner. The gases then moved up the cylinder through a grouping of baffles and out through an exit opening.

(d) The Cummings patent, No. 1,528,816, issued September 20, 1925, related to an incinerator. The purpose was to insure deodorization of the gaseous products of incinerators. A cylindrical container was provided with a side access hopper allowing refuse to be delivered to a container within the cylinder. Adjacent to the container a burner was specified for ignition of the refuse. The gases from the burning of the refuse then rose to a honeycombed partition which was preheated to an incandescent level by a burner adjacent to the partition, and the gases circulated through the honeycomb and out the exit port. The lower ignition burner was to be controlled so that the volume of by-product gases was such that they could be completely destroyed when passed through the upper partition.

(e) The Wilkins patent, No. 2,815,278, issued January 20, 1954, contained both method and apparatus claims for the reclamation of copper from copper scrap wire. The patentee's purpose was to avoid oxidation of the copper and discharge of smoke. Generally, the method involved the forming of a column-like pile of scrap wire over a bed of carbonaceous material, and igniting said carbonaceous base

and supplying air sufficient to generate a temperature above the melting point of copper. As a result thereof, hot gaseous combustion products, which are deoxidizing in relation to copper, moved upward through the wire scrap, and in conjunction with the heat of the carbonaceous bed caused destructive distillation of the organic wire covering without ignition of the by-products of the destructive distillation, said by-products moving upward through the scrap pile. The molten copper then filtered through the carbonaceous bed and out to a receptacle. Combustion air was regulated to insure a sufficient temperature at the ignition bed for burning of any remaining carbon residue fallout of the destructive distillation. The presence of carbon residue and the burning thereof provided a self-replenishing fuel source to continue distillation. As the scrap is melted, additional charging material is added. Claim (9) adds a secondary combustion chamber for the supplying of air and burning of the remaining by-products of the prior method.

24. The following were also relied upon by the defendant as appropriate prior art:

(a) The Edwards patent, No. 292,635, issued on January 29, 1884, related to a charcoal oven. Three separate pieces of apparatus were used in conjunction with each other. It had a conical oven with a conical door at the apex of the cone, and two rows of ports at the bottom of the cone at different heights parallel to the ground with damper controls on them. The lower access holes were to control the draft, and the upper access holes were to serve to evacuate smoke and gases during burning. A hoist mechanism was provided to raise the oven above the ground. A revolving template on a post was used to allow a workman to form a conical pile of wood. The purpose of the invention was to provide a portable metal oven that could be superimposed by the use of the hoist system over the conical pile of wood formed by use of the revolving template without need of a grate or foundation under the wood pile. The lower set of intake ports was used to furnish air in such amount as to

support slow combustion, and the upper set of ports allow smoke and gases to escape from the otherwise enclosed area.

(b) The Kurre patent, No. 245,179, issued on August 2, 1881, related to a stump burner composed of three or more cylindrical sections topped by a cone-shaped hood and a central smoke stack. The lower cylinder was placed over the stump, and the remaining members were then assembled on top of the lower cylinder. Access doors and controlled draft doors were provided in the lower cylinder.

(c) The Middaugh patent, No. 1,199,403 issued September 26, 1916, related to a refuse burner for particular application to the disposing of waste from sawmills. Two conical shells are attached to either side of supporting struts. The bottom of the conical shell has a grate with an intake air passage furnished to allow the inducing of air directly under the refuse. An opening is provided around the bottom of the outside shell to allow air to circulate up between the two shells and to be discharged through a hood attached to the shells. The circulation of air is to prevent the shell from overheating. An access door is located in the upper portion of the shell to allow refuse to be placed into the device.

(d) The Cassity patent, No. 1,126,388, issued on January 26, 1915, related to a portable stump burner. The burner consists of a casing of sheet metal in a frusto-conical shape with a damper inlet at the lower portion of the casing for controlling the draft. The lid or top of the casing is provided with an opening for the insertion of an air pipe to be used to direct air at stump roots after consumption of the stump itself. Said draft pipe is removable with a cover fitting over the lid when the air pipe is not used. Dirt was to be packed around the edges of the cone to preclude the entry of air.

25. The four additional patents relied on by the defendant do not show any new elements which were not already considered by the patent examiner.

26. Defendant also relies on the following three selections from the air pollution literature as prior art references:

(a) "Air Pollution Handbook," by Magill, Holden and Ackley (McGraw-Hill, 1956) at 13-19 relates the necessary elements of an incinerator to reclaim copper from copper scrap without the creation of a serious air pollution problem. The material suggests the use of a primary combustion chamber; a secondary chamber; and a final chamber for the introduction of additional combustion heat and air through air ports and fuel burners to insure complete combustion.

(b) "Air Pollution—United States Technical Conference on Air Pollution," edited by McCabe (McGraw-Hill, 1952) at 400-02 relates to the design of incinerators. The material suggests the use of a two-chamber system to insure full combustion of the effluent of the initial combustion chamber. Moreover, it is noted that the effectiveness of the secondary chamber is a function of the amount and velocity of combustion air supplied to the secondary chamber, and the heat in this chamber. If the temperature in the secondary chamber is low, gas or oil burners are suggested.

(c) A paper entitled, "Fuel-Fed Incinerator Research at New York University" found in "Proceedings of a Symposium on the Developments in Incinerator Research at New York University," published May 23, 1957, relates to improvement of apartment house incinerators in the City of New York by modification of existing single chamber incinerators so as to lessen the smoke and particle discharge. The approach indicated is to install a burner-blower combination upstream from the point of refuse ignition to facilitate the combustion of gaseous effluent and particles produced by the original and subsequent slow burning of the refuse charge. At a later point, referring to multi-chamber incinerators, it is pointed out that proper control of the volume of combustion air available in the primary chamber is critical to the prevention of smoke discharge. The use of burners in the secondary unit is recognized as

sometimes necessary to insure proper temperature ranges in the secondary or mixing chamber. In the event black smoke is discharged, it is recommended that primary combustion air be curtailed and secondary air increased.

27. The literature relied upon by the defendant, and not cited by the examiner, makes clear that multichamber incineration was known in the prior art to be an advantageous way to curtail smoke and particle discharge, prior to the time Mr. Spitz began his work. Specifically, it was known that smoke discharge is a function of two factors: the amount of combustion air available in the primary combustion chamber; and the capacity of the secondary chamber to handle the effluent moving upstream. The secondary or mixing chamber's efficiency depends on the air available and its temperature.

28. The Cummings patent '816, cited by the examiner, showed principles similar to those referred to in Finding 27 in the context of deodorizing gaseous products of refuse discharge. The literature cited by the defendant focuses on the importance of the above-mentioned factors in the context of air pollution control.

29. At the time Mr. Spitz conceived his idea, there was a need to improve the efficiency of copper reclamation procedures and to lessen the pollution discharge of the copper reclamation.

30. Plaintiff's patent met with limited commercial success.

31. The defendant uses its incinerators in the following way:

(a) a pile of scrap wire is formed

(b) the incinerator is placed on top of the pile

(c) the afterburner is ignited

(d) dirt is placed around the bottom of the incinerator

(e) a lighted torch is used to ignite the scrap by inserting the torch through each of the four doors of the incinerator

(f) after initial ignition, the four doors are closed

(g) the pile is left to burn for approximately 8 to 12 hours or longer depending on the material

(h) the afterburner is then shut off

(i) the incinerator is lifted off the pile.

32. The plaintiff's patent specifies that the pile of scrap wire be ignited prior to superimposing the incinerator over the pile of scrap wire.

33. Defendant's advertisements (P33, 34 & 35) are not false, deceptive or misleading.

34. The press release issued by the Union Corp. when it acquired Metal Bank of America was not false or misleading.

35. Defendant forwarded to a Brussels corporation a blueprint of the furnace used by the defendant, and the necessary information to utilize the furnace properly.

CONCLUSIONS OF LAW.

1. This Court has jurisdiction over the parties and subject matter.

2. Venue is proper in this judicial district.

3. Plaintiff is the rightful owner of United States Letters of Patent No. 3,076,421.

4. Claims 2, 3 and 4 of plaintiff's patent are invalid under 35 U.S.C. §103.

5. Defendant has infringed the plaintiff's method patent.

6. Defendant's infringement is willful.

7. Plaintiff has not proven a cause for unfair competition under Pennsylvania or federal law.

8. Defendant is not entitled to recover under 15 U. S. C. §2.

ORDER.

AND NOW, this 27th day of January, 1971, it is **ORDERED** that in Civil Action No. 38166 judgment is entered in favor of the defendant, L. Goldstein's Sons, Inc.

/s/ JOHN P. FULLAM, J.

APPENDIX.

Claim 1. The method of removing organic coverings from scrap insulated electrical wire without substantially melting or oxidizing the metal content thereof while yet obtaining substantially complete combustion of the organic coverings thereof, which method comprises introducing fuel to a loose random pile of such scrap wire, igniting said fuel and said scrap, admitting air to the so ignited pile of scrap at such limited rate and air-cooling the zone surrounding the so ignited scrap-pile at such rate that the combustion of the organic coverings in the scrap pile will be incomplete and generally limited to the extent necessary to volatilize such organic coverings without the complete combustion of a substantial portion thereof and that the temperature of the scrap pile is kept below the melting point of the metal content thereof, thereafter passing the resultant effluent of gaseous products of such incomplete combustion and of such volatized organic coverings and any solid particles entrained therein through a long refractory-lined flow-path commencing beyond the aforementioned air-cooled zone and introducing a sufficient amount of fuel and air into said flow-path near the upstream end thereof and burning such fuel to heat the refractory-lining of said flow-path and such effluent therein to a temperature necessary to effect a substantial combustion of the aforementioned effluent within said flow-path.

Claim 3. The method of removing organic coverings from random bales of scrap electric wire, in situ, on a loose scrap-pile thereof which comprises introducing fuel to such loose scrap-pile and igniting said fuel and said scrap-pile, superimposing upon such loose scrap pile, in situ, a bottomless pile-enclosing chamber and admitting air to the so ignited and enclosed scrap pile at such limited rate and air-cooling the zone of said ignited scrap and the resultant gaseous products within said chamber that substantially all of such organic coverings will be converted into gaseous

or gas-entrained materials, but with an incomplete combustion of a substantial portion of the so gasified and gas-entrained materials and that the temperature within said scrap-enclosing chamber will be below the melting point of the metal content of the electric wire, thereafter passing such effluent of the gaseous products from the scrap-pile and any solid matter entrained therein through a long refractory-lined flow-path beyond said chamber and introducing a sufficient amount of fuel and air into said flow-path near the upstream end thereof and burning such fuel within such flow-path to heat the refractory lining thereof and such effluent therewithin to a temperature necessary to effect a substantial combustion of such effluent within said flow-path.

Claim 4. The method of removing organic coverings from random bales of scrap electric wire, in situ, on a loose scrap-pile thereof, which comprises introducing fuel to such loose scrap-pile and igniting said fuel and said scrap-pile, superimposing upon such loose scrap pile, in situ, a bottomless pile-enclosing chamber and admitting air to the so ignited and enclosed scrap pile at such limited rate and air-cooling the zone of said ignited scrap and the resultant gaseous products within said chamber that substantially all of such organic coverings will be converted into gaseous or gas-entrained materials, but with an incomplete combustion of a substantial portion of the so gasified and gas-entrained materials and that the temperature within said scrap-enclosing chamber will be below the melting point of the metal content of the electric wire, thereafter passing such effluent of the gaseous products from the scrap-pile and any solid matter entrained therein through a long refractory-lined flow-path beyond said chamber and introducing a sufficient amount of fuel and air into said flow-path near the upstream end thereof and burning such fuel within such flow-path to heat the refractory lining thereof and such effluent therewithin to a temperature necessary to effect a substantial combustion of such effluent within

said flow-path, and thereafter passing the so resultant effluent through and in intimate contact with super heated refractory checkerwork just prior to its exit to the atmosphere to effect a substantial complete combustion thereof.

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 71-1295/6

TRIO PROCESS CORPORATION,
Appellant in No. 71-1295

v.

L. GOLDSTEIN'S SONS, INC.,
Appellant in No. 71-1296

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Argued March 24, 1972

Before SEITZ, *Chief Judge*, ADAMS and HUNTER, *Circuit Judges*

OPINION OF THE COURT

(Filed May 22, 1972)

ADAMS, *Circuit Judge*.

In this patent infringement case, we must first determine the validity of United States Patent No. 3,076,421, issued to Albert W. Spitz (Spitz) and owned by Trio Process Corp. (Trio), and then decide whether the district court's finding of willful infringement is correct.

The primary issue of validity is whether the process disclosed in the patent was obvious to a practitioner with ordinary skill in the appropriate art at the time the pro-

cess was developed. The infringement issue can be resolved by determining whether Trio is precluded by "file-wrapper estoppel" from asserting the doctrine of equivalents to show infringement.

THE PATENT

The patent which forms the subject matter of this case teaches a process of removing organic insulation from scrap wire. The method basically consists of the following steps:

1. Igniting a pile of scrap wire and organic insulation;

2. Superimposing a bottomless combustion chamber over the ignited pile;

3. Admitting air at a limited rate to the ignited pile and simultaneously air-cooling the outside of the combustion chamber so that the temperature of the ignited pile remains below the melting point of the wire;

4. Passing the products of the combustion—smoke and hydrocarbon gases—through an afterburner, into which is added fuel and air, so that the smoke and gases will be substantially oxidized.

The device disclosed in the patent by which the process may be practiced consists of a portable, sheet-metal conical combustion chamber upon which a refractory lined afterburner is superimposed.[1] Bunsen burners are suggested for introducing air and fuel into the afterburner chamber. The afterburner is supported by a frame. The frame also provides a point for attachment to a crane so that the furnace may be lifted, carried to the site of the scrap wire, and then lowered over such wire.

FACTUAL BACKGROUND

For the past several decades, there has been an increasing demand for non-ferrous metals, including cop-

1. To a layman, the furnace resembles a huge, inverted funnel. An illustration of Spitz's furnace is reproduced in the Appendix to this opinion.

per, for the electrical and other industries. To meet this demand, newly-mined metals are supplemented with metals reclaimed from scrap sources. Before scrap wire can be reclaimed, however, it is necessary to remove the insulation covering such wire.

Prior to the development of the method set forth in the Spitz patent, two procedures were utilized to remove insulation from scrap wire. One such method was to burn the wire in an open field. This procedure was inefficient and uneconomical as it required that the wire be raked back and forth to achieve proper burning, and did not provide satisfactory control over the oxidation and melting of the wire.[2] It also contributed to air pollution by releasing smoke and other gases into the atmosphere. The other process involved the rapid burning of scrap wire at high temperatures in forced draft, stationary furnaces. These fixed furnaces were expensive to build and difficult to use because the wire had to be prepared for burning and then transported to the furnaces. Moreover, the reclaimed metal would have to be removed from the furnace before it could become oxidized or melted. Both methods required substantial manpower for their effective utilization.

In late 1957, Spitz undertook an assignment from Franklin Smelting & Refining Company to develop an effective method of removing insulation from wire. Spitz investigated the procedures currently in use, devised a fixed furnace that could be charged from the top and unloaded from the bottom, and finally developed a concept converse to that previously employed, namely, the burning of the insulation in a portable furnace at a low temperature to be controlled by limiting the availability of air. Spitz's development had several advantages over the prior procedures: It reduced materials handling costs, it diminished air pollution, and it efficiently produced No. 1 grade copper scrap inexpensively by a meth-

---

2. It is important to control oxidation because excess oxidation can materially affect the physical properties of the metal.

od which could be operated by relatively untrained personnel.

Spitz applied for a patent in October of 1958. The original application contained both apparatus and method claims. All of the claims were rejected by the examiner on the basis of prior art.[3] In 1959, the application was amended, but the new claims were also rejected.[4] The apparatus claims were amended in 1960, and new method claims were added to the application. Once more, the apparatus claims were disallowed on the basis of prior art, and the method claims were rejected as being misdescriptive[5] in that they provided for superimposition of the furnace prior to ignition of the scrap, whereas the patent disclosure specified ignition before the furnace was lowered into place. After further amendment and abandonment of the apparatus claims, the patent containing method claims issued on February 5, 1963.

Early in 1959, L. Goldstein's Sons, Inc. (Goldstein) became aware of the Spitz method and tried to emulate it, probably because Goldstein found the other two methods of processing scrap wire, described at _____, *supra*, unsatisfactory. Goldstein hired first one, then another engineer to attempt to duplicate the Spitz process, but although these engineers observed the Spitz furnace in operation, they were unable to devise a similar procedure.

---

3. Prior art has been defined as follows:
"The existing state of knowledge in a particular art at the time an invention is made. It includes the issued patents * * *, publications, and all other knowledge deemed to be common thereto such as trade skills, trade practices, and the like." A. SMITH, PATENT LAW, CASES, COMMENTS AND MATERIALS 2 (1964).

4. The basis of the rejection of the new claims was that the apparatus was obvious in view of the prior art, and that the method claims were improper in that they relied on specific aspects of the apparatus and were disclosed in the prior art.

5. A claim is considered misdescriptive when it is not literally supported by the language of the specification or disclosure contained in the patent.

One of the engineers recommended a wire-chopping process which was eventually adopted for the reclamation of aluminum wire.[6] In November, 1959, Goldstein sought the opinion of a patent attorney as to the patentability of the Spitz furnace. The attorney advised that the furnace was not patentable. Goldstein did not seek an opinion as to the validity of the patent after issuance in 1963.

In 1960, Goldstein obtained licenses from Trio to use Spitz's method to process scrap wire.[7] Trio applied for and obtained on Goldstein's behalf appropriate permits from the City of Philadelphia. Spitz subsequently approached Goldstein in late 1964 and early 1965 to determine if it had any interest in additional furnaces. Goldstein stated that it had no interest, ostensibly because there was no room at its plant for the installation of additional furnaces. In actuality, Goldstein had engaged a metal fabricator to copy the Spitz furnace. Several of these copies were installed in Goldstein's Philadelphia facility,[8] and one was sent to AMA Metal Corporation, which had been acquired by Goldstein. Spitz endeavored to obtain clarification of Goldstein's position, and when an unsatisfactory answer was received, Trio charged Goldstein with patent infringement. Although Trio offered licenses for the additional furnances installed by Goldstein, the offer was refused and Goldstein terminated the license agreement.

In May, 1969, Trio filed suit against Goldstein for willful patent infringement, contributory infringement, and

---

6. Goldstein's research continued through 1965, but apparently was never successful.

7. Licenses were also obtained by Franklin Smelting in Philadelphia, AMA Metal Company in New York, Minkin Metal Company in Michigan, Luria Brothers, Inc. in Pennsylvania, and Phelps Dodge in Arizona.

8. Applications for permits filed by Goldstein with the air pollution control section of the Philadelphia Department of Health specifically recite that each furnace to be installed by Goldstein is identical to an incinerator which was previously licensed by the Department of Health. The previously licensed incinerator was in fact a furnace provided by Trio.

unfair competition. Goldstein's answer denied infringement and asserted as an affirmative defense that the patent was invalid under 35 U.S.C. §§101, 102, 103 and 112. After a trial without a jury, the patent was held to have been willfully infringed, but invalid as obvious under 35 U.S.C. §103. The district court did not rule on the issue whether the patent was invalid under 35 U.S.C. §112. Trio appealed from the holding of invalidity and Goldstein cross-appealed on the issue of infringement.

VALIDITY OF THE PATENT

We begin this discussion with the pole star proposition that a patent is presumed to be valid and that the burden of proof is on the party alleging invalidity.

Congress provided in 35 U.S.C. §282 (1970), that: "A patent shall be presumed valid. * * * The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it." And this Court has recognized that " * * * the burden of proving invalidity in the face of the presumption is a heavy one." Schmidinger v. Welsh, 383 F.2d 455, 462 n. 10 (3d Cir. 1967); *cert denied*, 390 U.S. 946 (1968). Indeed, invalidity must be demonstrated by clear and convincing proof. Ever-Wear Inc., v. Weiboldt Stores, Inc., 427 F.2d 373 (7th Cir. 1970); General Foods Corp. v. Perk Foods Co., 419 F.2d 944 (7th Cir. 1969), *cert. denied*, 397 U.S. 1038 (1970); Moon v. Cabot Shops, Inc., 270 F.2d 539 (9th Cir. 1959), *cert. denied*, 361 U.S. 965 (1960).

Because of the special public interest surrounding the issue of patent validity,[9] we have carefully evaluated the record and the district court's findings and conclusions with the above stated precepts in mind.

---

9. Sinclair & Carrol Co. v. Interchemical Corp., 325 U.S. 327, 330 (1945); Royal Typewriter Co. v. Remington Rand, Inc., 168 F.2d 691, (2d Cir.), *cert. denied*, 335 U.S. 825 (1948); *see generally*, Note, *In Rem Validity—A Two-Sided Coin*, 59 GEO. L. J. 73, 80-81 (1970).

A. Obviousness

As stated above, the district court held that the patent was invalid on the ground that the invention was "obvious." Section 103 provides, in pertinent part: "A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *"

Although Section 103 was enacted in 1952, it was not until 1966 that the Supreme Court definitively construed it in a trilogy of cases. Graham v. John Deere Co., 383 U.S. 1 (1966); Calmar & Colgate-Palmolive Co. v. Cook Chemical Co., *id.*; United States v. Adams, 383 U.S. 39 (1966). In *Graham*, the Supreme Court set forth the primary tests and secondary criteria for determining obviousness:

> "[T]he scope and content of the prior art; * * * differences between the prior art and the claims at issue; * * * the level of ordinary skill in the prior art. * * * Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U. S. at 14.[10]

The *Adams* case illustrates that where all the elements of an invention were known in the prior art but not utilized together, if the combination of the elements produced unexpected results different from the prior art, an invention may be patentable, particularly where the prior art indicates that the procedure utilized by the patent will be unproductive. 383 U. S. at 50-51; *accord* D. DUNNER, J.

---

10. With regard to the primary tests, the Supreme Court has "admonished that 'strict observance' of those requirements is necessary." Anderson's Black Rock, Inc. v. Pavement Salvage Company, Inc., 396 U. S. 57 (1969).

GAMBRELL, & I. KAYTON, PATENT LAW PERSPECTIVES, CURRENT SERVICE, at A.5 (1966-67 Annual Review).

Trio maintained that because the district court did not specifically make the three primary findings referred to in *Graham*, reversal is required. But *Graham* and *Anderson's Black Rock* do not require that the three primary findings be made, but rather, only that the three primary tests be considered in the findings made by the district court. *See* Frantz Mfg. Co. v. Phoenix Mfg. Co., ____ F. 2d ____, ____ (7th Cir. 1972). Here, the trial judge's findings indicate that the scope of the prior art includes the reclamation of scrap wire, the manufacture of charcoal, the control of air pollution, and the incineration of tree stumps and sawdust. The content of the prior art was found to include portable furnaces, fixed furnaces, conical furnaces, and afterburners. The analysis of the prior art performed by the district court clearly highlights the differences between the claims at issue and the prior art as well as the similarities.

Although it would have been preferable for the trial judge to have set forth his findings with regard to the ordinary level of skill in the pertinent art with greater specificity, the findings actually made indicate that an ordinary person skilled in the art would be aware of the use of fixed furnaces operated at high temperatures to process scrap wire, the use of portable furnaces operated at low temperatures with limited air to produce charcoal, and the use of afterburners to cleanse the effluent gases. Furthermore, the district court made specific findings with respect to the needs of the industry and the commercial success of the invention. Accordingly, we hold that the district court adequately complied with the requirements of *Graham*. We have examined the record with respect to the findings of the district court discussed above, and find substantial evidence supporting them.[11]

---

11. Trio has assigned as error the admission into evidence of the opinion testimony Dr. Edward Adler on the ground that he was not qualified under the rule of Arnold v. Loose, 352 F.2d 959 (3d

The ultimate legal conclusion of the district judge that the patent was invalid under Section 103 carries with it the necessary implication that the differences between the invention *sub judice* and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the pertinent art. It is here that we believe the district court erred.

When the patent examiner approved the Spitz patent, he cited seven prior patents he considered to be in the prior art. These patents disclosed, *inter alia*, an apparatus and method for reclaiming copper wire,[12] an afterburner to deodorize effluent gases,[13] an apparatus for the odorless burning of refuse,[14] a portable conical incinerator for burning tree stumps,[15] and a portable charcoal kiln which disclosed the concept of limited access of air.[16] Despite these references, the examiner concluded that the invention was unobvious, and such conclusion is presumptively correct.

To rebut this conclusion, Goldstein cited eight additional patents and three literature references. In holding the patent invalid, the district court relied on five of the patents that were before the examiner (discussed *supra*), four of the patents cited by Goldstein,[17] and the three

---

Cir. 1965), to testify as an expert. However, Trio has not indicated in what manner such testimony prejudiced it. In any event, even excluding such testimony, the evidence in the record is sufficient to support the findings of the trial judge. Therefore, the error, if any, was harmless under Rule 61, Fed. R. Civ. P.

12. Wilkins Patent No. 2,815,278, teaching the use of a high temperature furnace with an afterburner.

13. Breitweiser Patent No. 1,773,256.

14. Cummings Patent No. 1,528,816.

15. Morgan Patent No. 1,082,644.

16. Lovelace Patent No. 266,850.

17. Edwards Patent No. 292,635 (conical charcoal oven; slow combustion); Kurre Patent No. 245,179 (stump burner); Middaugh Patent No. 1,199,403 (sawdust burner designed for rapid burning utilizing air-cooling to prevent overheating); Cassity Patent No. 1,126,388 (stump burner).

literature references.[18] A careful reading of the patents and literature reference cited by Goldstein indicates that they are merely cumulative to the references before the examiner. As such, they add no new material from which the district court could conclude that had the examiner read them, he would have held that the invention was unpatentable for obviousness. None of the references cited by the district court, individually or taken as a whole, indicate that organic insulation can be burned in a commercially feasible manner from scrap wire at low temperature without oxidizing or melting the wire.[18a] And even when all the references are viewed in conjunction with all the testimony taken at the trial, the evidence still falls short of "clear and convincing" proof that the method disclosed by the patent would have been obvious to a person with ordinary skill in the relevant art at the time Spitz developed his process. This is particularly so where, as here, the prior

18. Two of the literature references concern the use of afterburners to reduce air pollution; the third refers to refuse burning in apartment house incinerators and teaches both the use of an afterburner and the control of air in the combustion chamber to reduce pollution.

18a. It could be argued that it would be obvious to a person with ordinary skill in the art of wire reclamation to burn the insulation from wire at a temperature lower than the melting point of the wire, and that once this solution were arrived at, the method would be obvious in view of the prior art. Although this argument has superficial appeal, it is not supported by the facts of this case. Indeed, Goldstein, after being apprised of Spitz's concept, was still unable to reduce it to practice, prior to the issuance of the patent, without first obtaining instruction from Trio.

In any event, invention might lie in the realization of the exact problem to be solved. When the identification of the problem is not obvious, the invention can be patentable, even though the solution to the problem would then be obvious. Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923). *But cf.* Graham v. John Deere Co., *supra*, 383 U.S. at 25. The proper test is whether the process as a whole would have been obvious to one of ordinary skill in the art, not whether it would be "obvious to try" a certain solution to the problem at hand. In re Dien, 371 F.2d 886 (C.C.P.A. 1967).

art indicates that high-temperature burning, rather than the low-temperatures employed by Spitz, is a more advantageous means of accomplishing the intended result. United States v. Adams, *supra*.

Goldstein argues, however, that the method patented by Spitz was obvious at the time the invention was made because each of the steps described in the Spitz claims was well known in the prior art. However, the essence of the Spitz invention did not lie in the individual steps, but rather, consisted of combining the steps in an unsuggested manner into a process that would achieve a substantially different function and result from the other processes of which the individual stages were a part.[18b] Where such occurs, the invention of a process may be patentable despite the fact that the individual phases were known in the art. *See* Shaw v. E.G. & A.C. Whiting Co., 417 F.2d 1097 (2d Cir. 1969); *cf.* Anderson's Black Rock Inc. v. Pavement Salvage Co., *supra*. *See generally*, D. DUNNER, J. GAMBRELL, I. KAYTON, *supra*, at Dev. A. 1-3 to -7 (1970). Developments.[19] It is the subject matter as a whole which must be con-

---

18b. The functions performed by the devices in the prior art include the manufacture of charcoal, essentially a distillation process, and the burning of refuse, such as sawdust and tree stumps, a combustion process in which there is no attempt to preserve any sort of unoxidized by-product. In contrast, the function of the Spitz method is to burn insulation while preserving intact as the primary product No. 1 grade scrap wire. And it follows that here, the result is different in that the end product, scrap wire, is preserved in its original physical and chemical state, whereas the other devices produced products in which the physical or chemical state of the subject matter was substantially altered.

Examination of the two methods of producing scrap wire known in the prior art shows a facial similarity in function and result. But closer analysis demonstrates that the result of the Spitz process is not the mere production of scrap wire, but the production of such wire in a more economical manner, in that operating and material handling costs are reduced by resort to this method.

19. These citations all refer to combination apparatus patents, but the principles apply equally well to a multi-step process claim.

sidered in determining obviousness. In re Wiggins, 397 F.2d 356 (C.C.P.A. 1968).[20]

B. Specific disclosure

Although Goldstein asserted in its answer that the patent was invalid for failure to comply with 35 U.S.C. §112,[21] the district court did not decide this issue. Here, Goldstein urges that the holding of invalidity may be affirmed on this ground alone. In support of its argument, Goldstein contends that Spitz did not disclose certain shortcomings of his invention, Spitz fraudulently misrepresented both the shortcomings of the prior art and the result reached by the use of his invention, the patent fails to teach the necessity to observe the presence or absence of smoke, the patent does not describe any specific temperature ranges, and that the patent does not set forth the best mode of operation.

With regard to the allegations of omissions and misrepresentations, we hold that, on the facts of this case, such were not material, in that they did not relate to the statutory conditions of patentability: novelty, 35 U.S.C. §102; obviousness, 35 U.S.C. §103; or utility, 35 U.S.C. §101.[22] In this respect, Monsanto Co. v. Rohm & Haas Co.,

---

20. The *Wiggins* opinion was written by Justice Clark, who authored Graham v. John Deere Co., *supra*.

21. Section 112 provides, *inter alia*:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person *skilled in the art* to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." (emphasis added)

22. Arguably, the allegation regarding the inability of the invention to cope with metal-sheathed wire or aluminum wire bears on utility, but when the misrepresentations are measured against the appropriate standards, it becomes obvious that even if fuller disclosure had been made, Spitz's process still would have been patentable.

____ F.2d ____ (3d Cir. 1972), is distinguishable because there the misrepresentations directly related to anticipation (novelty), obviousness, and utility, and the patent might not have issued had full disclosure been made.

The other Section 112 arguments relate to the lack of disclosure or vagueness of the operating parameters of the process. However, as distinguished from Section 103, dealing with obviousness, Section 112 refers to persons skilled in the art, and the disclosure must be evaluated with respect to such persons. Patent specifications need not be so detailed as "production specifications". In re Gay, 309 F.2d 768 (C.C.P.A. 1962).[23] Regarding the allegations that the best mode of operation was not disclosed, the statute as interpreted by the courts requires only that the best mode of operation known to the inventor at the time the application was filed be set forth. *Id.* The examiner determined that the disclosure of the patent was adequate, and a review of the record as a whole indicates that the evidence falls short of "clear and convincing" proof that the specification fails to teach a person skilled in the art how to operate the process.[24]

C. Late claiming and Misuse

In its brief to this court, Goldstein urges that the patent should be held invalid because of late claiming under 35 U.S.C. §132, and unenforceable because Trio misused the patent in a variety of respects. However, late claiming and

23. *See also* Bennett v. Halahan, Aronson & Lyon, 285 F.2d 807 (C.C.P.A. 1961).

24. The temperature of the burning pile of scrap wire is limited by the melting point of the metal, which would be known to a person skilled in the art. The patent also states that the gases emitted from the afterburner "are virtually colorless," and a person skilled in the art would be able to determine the proper temperature for afterburning easily by observing the presence or absence of smoke. Although the length of the afterburner is not specified, the patent drawings indicate that it is to be approximately equal to the height of the cone. In any event, such is not a critical part of the invention.

misuse are affirmative defenses which must be pleaded and proved. 35 U.S.C. §282 (1970). Because Goldstein's answer to the complaint did not raise these issues, we hold these defenses to have been waived under Rule 8(c), Fed. R. Civ. P., and need not consider them further.

WILLFUL INFRINGEMENT OF THE PATENT

Goldstein contends that the district court's conclusion of willful infringement is erroneous as a matter of law. The evidence disclosed that the only deviation in Goldstein's process from the method described in the patent was that Goldstein ignited the pile of wire prior to superimposing the furnance, whereas the patent stipulates the reverse order of these steps. Trio asserts that it is immaterial whether the pile is ignited before or after superimposition of the furnace, and that the conclusion of the district court is therefore correct under the doctrine of equivalents.

The Supreme Court explained the doctrine of equivalents and the conditions for its invocation in Graver Tank & Mfg. Co. v. Linde Air Products Co.:

> "The essence of the doctrine is that one may not practice a fraud on the patent. * * * 'To temper unsparing logic and prevent an infringer from stealing the benefit of an invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.'" 339 U.S. 605, 608 (1950).

Here, by reversing the order of the steps of the process, there is produced "substantially the same function" (ignition of the insulation in the pile of scrap wire in preparation for burning) "in substantially the same way" (burning the insulation at low temperature) "to obtain the same results" (Number 1 grade scrap copper wire). Unless Trio is barred from asserting the doctrine of equivalents because of

"file-wrapper estoppel",[25] the conclusion that the patent was infringed must be affirmed.

The doctrine of file-wrapper estoppel provides that where a patentee abandons or redrafts a claim more narrowly to avoid rejection on the basis of prior art, then the substance of the claim as originally drafted which was thereby excluded cannot be recaptured by resort to the doctrine of equivalents. Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 (1942). Graham v. John Deere Co., 383 U.S. 1, 33 (1966); Schmidinger v. Welsh, 383 F.2d 455 (3d Cir. 1967), *cert. denied*, 390 U.S. 946 (1968); Chemical Construction Corp. v. Jones & Laughlin Steel Corp., 311 F.2d 367 (3d Cir. 1962).

The doctrine is based on the theory that the prior art is either in the public domain or already patented, so that the patentee may not claim it as part of his invention. By redrafting or abandoning a claim in the face of a prior art rejection, the patentee is conceding that he has not invented what he thereby disclaims, and therefore will not be heard to assert, at a later date, what he disclaimed as his invention. Accordingly, for "file-wrapper estoppel" to become operable, it is necessary, at the least, that a claim have been narrowed to avoid the prior art. Bishman Mfg. Co. v. Stewart-Warner Corp., 380 F.2d 336 (7th Cir.), *cert. denied*, 389 U.S. 897 (1967).

Here, the claims were redrafted, not because they trespassed upon the prior art, but because they were considered misdescriptive in view of the specification of the patent. The rejection here was a technical matter based on the Rules of Practice of the Patent Office, and had nothing to

---

25. The file wrapper is "[t]he Patent Office file consisting of the original application, Office Actions, amendments and other written matter pertaining to the filing and prosecution of the application, and the issuance of the patent thereon. The documents are those actually exchanged between the applicant and the Patent Office. The file wrapper provides the written history of the application in the Patent Office. . . ." A. SMITH, *supra*, at 2.

do with the question whether the matter rejected was patentable. In such a situation, it would not be equitable to deprive a patentee of the full fruits of his invention because of a formalistic rule of the patent office. *See* Peterson Filters & Engineering Co. v. Eimco Corp., 155 U.S.P.Q. 89 (D. Utah, 1967), *aff'd* 406 F.2d 431, 438 (10th Cir. 1968).

For these reasons, we hold that, on the basis of the record developed below, the district court's conclusion of law that the patent had been infringed was not incorrect.

Goldstein next asserts that even if it were held to be an infringer, such infringement was not willful because it sought the advice of patent counsel as to the patentability of Spitz's invention. However, the opinion of counsel was not sought after the patent issued, even though more than a year elapsed after issuance before Goldstein began to infringe. This alone is enough to support a conclusion of willfulness, Maxon Premix Burner Co. v. Mid-Continent Metal Prods. Co., 270 F. Supp. 164 (N.D. Ill. 1967), and when viewed in conjunction with the totality of Goldstein's actions, including sending blueprints and operating instructions to a foreign company, we cannot say that the trial court's conclusion in this regard was erroneous.

CONCLUSION

The judgment of the district court with regard to the validity of the patent will be reversed, the judgment with regard to willful infringement will be affirmed, and the cause will be remanded for further proceedings consistent with this opinion. Costs taxed in favor of Plaintiff, Trio Process Corporation, in both appeals.

Arlin M. Adams

ARLIN M. ADAMS,
Circuit Judge

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

Nos. 71-1295 and 71-1296

TRIO PROCESS CORPORATION
Appellant in No. 71-1295

v.

L. GOLDSTEIN'S SONS, INC.
Appellant in No. 71-1296

SUR PETITION FOR REHEARING

Present *Chief Judge* SEITZ, VAN DUSEN, ALDISERT, ADAMS, GIBBONS, ROSENN, ROSEN and HUNTER, *Circuit Judges*

The petition for rehearing filed by L. GOLDSTEIN'S SONS, INC. in the above entitled case having been submitted to the judges who participated in the decision of this court and to all the other available circuit judges of the circuit in regular active service, and no judge who concurred in the decision having asked for rehearing, and a majority of the circuit judges of the circuit in regular active service not having voted for rehearing by the court in banc, the petition for rehearing is denied. The petition for rehearing relies on the case of Deepsouth Packing Company v. Laitram Corp., ____ U.S. ____ (1972), the opinion in which was rendered after the opinion in this case.

Deepsouth Packing Company is not inconsistent because it deals with infringement and not intent which is an element of willfulness.

By the Court.

Dated: July 5, 1972 .....

Judge

SEP 29 1972 FILE COPY

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-294

L. GOLDSTEIN'S SONS, INC.,

Petitioner,

vs.

TRIO PROCESS CORPORATION,

Respondent.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE

GEORGE N. HIBBEN
HIBBEN, NOYES & BICKNELL
332 South Michigan Avenue
Chicago, Illinois 60604

JOHN A. REILLY
KENYON & KENYON REILLY
CARR & CHAPIN
59 Maiden Lane
New York, New York 10038

Counsel for Petitioner

Of Counsel:

WILLIAM J. UNGVARSKY
EDWARD J. HANDLER, III
ARTHUR D. GRAY

TABLE OF CONTENTS

	PAGE
Motion For Leave To File Brief Amicus Curiae	1a
Brief On Behalf Of The Ford Motor Company, Amicus Curiae	1
I Authority To File	1
II Interest Of The Ford Motor Company	1
III The Issue Presented	2
IV Reasons To Grant Certiorari	4
A. The Conflict Among The Circuits	4
B. The Ramifications Of The File Wrapper Estoppel Doctrine	6
Conclusion	9

TABLE OF CITATIONS

CASES:

	PAGE
Bishman Mfg. Co. v. *Stuart-Warner Corp.*, 380 F.2d 336 (7 Cir.), *cert. denied*, 389 U S. 897 (1967)	4n
Deepsouth Packing Co. v. *Laitram Corp.*, 301 F. Supp. 1037, 1060 (E.D. La. 1969), *aff'd* on other grounds, 443 F.2d 928 (5 Cir 1971), *rev'd* on other grounds, 406 U.S. 518 (1972)	5n
Ellipse Corp. v. *Ford Motor Co.*, 452 F.2d 163, 168 (7 Cir.), *cert. denied*, 406 U.S. 948 (1972), pet. for rehearing filed, July, 1972, Sup. Ct. Doc. No. 71-1147	1, 5n
Graver Tank & Mfg. Co. v. *Linde Air Prods. Co.*, 339 U.S. 605, 617 (1950)	6
Keating v. *Stearnes Imperial Co.*, 347 F.2d 444 (7 Cir. 1965)	4n
Powder Power Tool Corp. v. *Powder Actuated Tool Co.*, 230 F.2d 409 (7 Cir. 1956)	4n
Schriber-Schroth Co. v. *Cleveland Trust Co.*, 311 U.S. 211, 221 (1940)	8n

RULES:

Rule 42, Rules Of The Supreme Court	1
Rule 58(2), Rules Of The Supreme Court	2

Other Authorities

Koykka, *Infringement of Patents*, 42 F.R.D. 43, 67 (1967)	3, 7n

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-294

L. GOLDSTEIN'S SONS, INC., *Petitioner,*

vs.

TRIO PROCESS CORPORATION, *Respondent.*

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

Ford Motor Company hereby respectfully moves for leave to file the attached brief *amicus curiae* in this case, presenting views, cases and analysis generally supportive of Petitioner's position which may not be advanced by either party. The consent of the attorney for the Petitioner has been obtained. The consent of the attorney for the Respondent was requested but refused, thus necessitating the filing of this motion under Supreme Court Rule 42(3).

The interest of the Ford Motor Company in this case arises from the fact that it is currently petitioning for a rehearing of the denial of a petition for certiorari in *Ford Motor Co.* v. *Ellipse Corp.*, Sup. Ct. Docket No. 71-1147. The First Question presented in Ford's petition for certiorari is identical to the First Question of the present petition.

The Circuit Courts of Appeal are in conflict on the question of what circumstances will estop a patentee from taking a position as to the meaning of claims when asserting them during litigation inconsistent with the position taken before the Patent Office when obtaining the claims, and both petitions seek a resolution of this conflict. This question

is referred to as the scope of the file-wrapper estoppel doctrine.

In the instant case, Petitioner has presented and analyzed some, but not all, of the cases and authorities demonstrating the conflict among the Circuits on this issue. Movant has done exhaustive research on this particular question and it is believed that the attached brief, which *amicus curiae* is requesting permission to file, supplements the Petitioner's presentation, analysis and portrayal of the split among the Circuits on this issue, as well as presenting an analysis of some important ramifications of the file-wrapper estoppel doctrine not presented by Petitioner.

Such additional analysis and research should materially assist the Court in reaching a decision to grant Certiorari on this issue which in turn should produce a uniform rule on file-wrapper estoppel in the federal trial and appellate courts.

This motion has been filed as soon as possible after learning that the issue of file-wrapper estoppel had been presented in the instant petition.

Accordingly, granting of this motion is earnestly requested.

Respectfully submitted,

George N. Hibben
Hibben, Noyes & Bicknell
332 South Michigan Avenue
Chicago, Illinois 60604

John A. Reilly
Kenyon & Kenyon Reilly
Carr & Chapin
59 Maiden Lane
New York, New York 10038

Counsel for Movant

Of Counsel:

William J. Ungvarsky
Edward J. Handler, III
Arthur D. Gray

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-294

L. GOLDSTEIN'S SONS, INC.,

Petitioner,

vs.

TRIO PROCESS CORPORATION,

Respondent.

BRIEF ON BEHALF OF THE FORD MOTOR COMPANY, AMICUS CURIAE

I. AUTHORITY TO FILE

This *amicus curiae* brief is presented pursuant to Rule 42 of the Rules of the Supreme Court, together with movant's motion for leave to file the same.

II. INTEREST OF THE FORD MOTOR COMPANY

In March of 1972, Ford Motor Company (hereinafter Ford) filed a Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit in the case of *Ford Motor Co.* v. *Ellipse Corp.*, Sup. Ct. Doc. No. 71-1147. That Petition was denied on May 22, 1972, Mr. Justice Douglas noting his view that the writ should have been granted. In July, 1972, after being granted an

extension of time, Ford filed a Petition for Rehearing of the Court's order denying certiorari. The Petition for Rehearing is based on "other substantial grounds available to petitioner although not previously presented. . . ." (Sup. Ct. Rule 58(2)) and is presently pending before this Court.

Ford has just recently become aware that the precise question which it raised in its Petition for Certiorari, has now been independently raised by the Petitioner in this case. Ford has no concern with and expresses no views on the private interests of the parties to this litigation. Ford seeks only to aid this Court in deciding whether to grant certiorari to review the important question of the proper application of the basic doctrine of file-wrapper estoppel. Since this precise question was exhaustively researched by Ford in connection with its own petition for certiorari, it is felt that Ford can bring valuable assistance to this court in demonstrating that the question presented is one of critical importance in patent law deserving review by this Court.

III. THE ISSUE PRESENTED

The doctrine of file-wrapper estoppel has always been basic to the proper administration and application of the patent laws. An application spends anywhere from many months to many years in the United States Patent Office before it becomes an issued patent. During this time those charged with the duty to do so, the Patent Office Examiners, carefully examine each application to insure its compliance with myriad statutory requirements. The work of these Examiners and the changes in the application made to make it comply with these statutory requirements, are all carefully recorded in the record of the application called the file-wrapper. It is this record which tells the world how the patent is to be construed and interpreted. Without it,

the words of an issued patent could be unduly manipulated to assume different meanings depending on the circumstances of the moment. Simply stated, the doctrine of file-wrapper estoppel, estops an inventor from later changing the positions, reflected in the file-wrapper, which he took when obtaining his patent. The doctrine has been described as follows:

> "In the course of the proceedings seeking the grant of a patent, the inventor will have said many things in explanation of his invention. He may have given up some claims, added others, modified language here and there.
>
> If, in order to obtain his patent, the inventor gives up a claim, or restricts what he has claimed, he is thereafter bound by that surrender. This is the same doctrine that would be applied in the construction of a contract. If, in the negotiation of a contract, one of the parties objects to particular language on the ground it covers matter he is not willing to have covered by the contract, and the other agrees to exclude it, and language then is altered for the purpose of excluding that particular matter, that contract cannot thereafter be construed to bring back into it what the parties agreed to exclude. No matter what construction may be given to the substituted language, it may not thereafter be read to bring that particular matter back into the contract." [1]

Thus, it is apparent that the doctrine of file-wrapper estoppel is a basic tool in the interpretation of any patent. Yet, as pointed out in the instant petition and in Ford's petition, the Circuit Courts of Appeal are hopelessly divided on the question of under what circumstances this vital doctrine will apply. Certain Circuits have held that the change in position taken by the applicant in the Patent Office, must have been in response to a *prior art rejection*

1. Koykka, *Infringement of Patents*, 42 F.R.D. 43, 66-67 (1967).

in order for file-wrapper estoppel to apply. On the other hand, other Circuits have held that changes in position taken by the applicant for other reasons can also result in estoppel. It is petitioner's contention, which this *amicus curiae* brief supports, that this sharp conflict should be resolved by this Court.

IV. REASONS TO GRANT CERTIORARI

A. *The Conflict Among The Circuits*

The instant petition sets out and analyzes decisions of the various Circuit Courts of Appeal establishing the conflict among the Circuits. Ford, as *amicus curiae,* respectfully submits that the conflict is even more deep-rooted than Petitioner suggests. Thus, Petitioner asserts that the Seventh Circuit case[1] cited by the Court below and other cases[2] located by Petitioner put the Seventh Circuit with those courts which do *not* limit file-wrapper estoppel to prior art rejections.[3] However, the Petition fails to note the very definite position taken by the Seventh Circuit in the case in which *amicus curiae* is a party, wherein the Seventh Circuit stated:

> "The application of the doctrine is limited to changes made to overcome rejections by the Patent Office because the claim was anticipated by the prior art. . . . It will not apply where changes in the claim are

1. *Bishman Mfg. Co.* v. *Stuart-Warner Corp.,* 380 F.2d 336 (7th Cir.), *cert. denied,* 389 U. S. 897 (1967).

2. *Powder Power Tool Corp.* v. *Powder Actuated Tool Co.,* 230 F.2d 409 (7th Cir. 1956); *Keating* v. *Stearnes Imperial Co.,* 347 F.2d 444 (7th Cir. 1965).

3. Pet. pp. 11-12, 15. The Petition for Certiorari filed herein is referred to throughout this brief as Pet.

> directed to merely overcoming difficulties in particular wording or indefiniteness. . . .[1]

Accordingly, there is a conflict within the Seventh Circuit itself as well as among the Circuit Courts of Appeal.

At this juncture, about the only thing that seems clear is that there is great confusion within and among the Circuit Courts of Appeal as presented by the instant Petition, the Ford Petition and recognized by a district judge in the following language:

> "Plaintiff urges that the doctrine of file-wrapper estoppel applies only to those claims amended or withdrawn in order to overcome objections based on the prior art, correctly citing as authority the decision of the Tenth Circuit in McCullough Tool Co. v. Well Surveys, Inc., 1965 343 F.2d 381, 403, in which the Court said the doctrine 'is not applicable where the patentee's difficulty results not from prior art similarities but from the wording and indefiniteness of the claims.' And, other courts have referred to the doctrine, in *dicta,* in the terms of prior art rejections. On the other hand, the First and Sixth Circuits have said the doctrine extends to all cancellations and amendments, not just those based on the prior art. See, Borg-Warner Corp. v. Paragon Gear Works, 1 Cir., 1965, 355 F.2d 400; Parke-Davis & Co. v. American Cyanamid Co., 6 Cir., 1953, 207 F.2d 571."[2]

It is respectfully submitted that this conflict has grown to such proportions that it can only be resolved by this Court.

---

1. *Ellipse Corp.* v. *Ford Motor Co.,* 452 F.2d 163, 168 (7th Cir.), *cert. denied,* 406 U.S. 948 (1972), Pet. for rehearing filed, July 1972, Sup. Ct. Doc. No. 71-1147.

2. *Deepsouth Packing Co.* v. *Laitram Corp.,* 301 F. Supp. 1037, 1060 (E.D. La. 1969), *aff'd* or other grounds, 443 F.2d 928 (5 Cir. 1971), *rev'd on other grounds* 406 U.S. 518 (1972) (footnotes omitted).

B. *The Ramifications Of The File-Wrapper Estoppel Doctrine*

Petitioner has amply presented one reason why resolution of the above-mentioned conflict is essential, namely to restore a degree of certainty to the interpretation of patent claims.[1] In the case of the business man dealing with an issued patent, this will encourage him to undertake non-infringing research and development, secure in the knowledge that what does not infringe in one Circuit is not likely to be deemed to infringe in another. Secondly, from the viewpoint of the courts, it will discourage forum shopping, a practice which the Court has always discouraged.

However, the proper resolution of the conflict has far greater ramifications, not discussed by Petitioner, and thus presented here, *amicus curiae*. While as stated earlier, Ford as *amicus curiae* has no interest in the outcome of this litigation, it files this brief in support of the granting of certiorari because the Third Circuit Court of Appeals has erred in limiting the doctrine of file-wrapper estoppel *only* to situations involving prior art rejections.

The prime import of the doctrine of file-wrapper estoppel is as a fetter on the doctrine of equivalents. The dangers of the doctrine of equivalents were clearly spelled out by Mr. Justice Black in his dissent to the decision of this Court which expanded that doctrine. In *Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*,[2] Mr Justice Black stated:

> "The Court's ruling today sets the stage for more patent 'fraud' and 'piracy' against business than could be expected from faithful observance of the congressionally enacted plan to protect business against judicial expansion of precise patent claims. Hereafter a manufacturer cannot rely on what the language of a patent claims. He must be able, at the

1. Pet. pp. 16-17.
2. 339 U.S. 605, 617 (1950).

> peril of heavy infringement damages, to forecast how far a court relatively unversed in a particular technological field will expand the claim's language after considering the testimony of technical experts in that field. To burden business enterprise on the assumption that men possess such a prescience bodes ill for the kind of competitive economy that is our professed goal."

These dangers can only be avoided if there is something to prevent the unlimited expansion feared by Justice Black. That something is the doctrine of file-wrapper estoppel which has been explained in relation to the doctrine of equivalents as follows:

> "The doctrine of equivalents—which expands a patent claim—is sometimes referred to as a rule to prevent fraud on the inventor: to prevent the theft of his invention by one making insignificant changes to avoid the patent. On the other hand, the opposite —the constricting—doctrine of file-wrapper estoppel may be referred to as a rule to bar fraud on the Patent Office and the public: to prevent the patentee from reclaiming that which, in order to obtain his patent, he has surrendered. If an inventor gets a patent on the basis of representations he makes to the Patent Office, it is manifestly right and just that his patent, when it issues, be read in the light of those representations."[1]

If file-wrapper estoppel is limited to situations where there has been a prior art rejection it leads to the very unwarranted expansion of patent claims feared by Justice Black. For example, in the instant case it permits the patentee to reclaim a series of process steps which the Patent Office ruled were never disclosed in his application and thus not capable of being claimed by him. Thus,

1. Koykka, *Infringement of Patents, supra.*

although he could not have obtained such a claim in the Patent Office, he is awarded it by the Court just because the Patent Office did not object to his claim because of prior art, but rather because of one of the many other equally fundamental statutory requirements an applicant must comply with.

In addition, as explained in Ford's own Petition for Certiorari, this Court has held the doctrine of file-wrapper estoppel to apply to amendments which broaden claims as well as to those which narrow claims.[1] That is, a patentee should not be able to obtain a broad claim which he asserts against the public for many years, and then, when the claim is challenged, narrow the claim back to where it was originally because the broadened claim is so broad as to be invalid. However, a claim is never broadened in response to a prior art rejection. Thus, those courts which hold file-wrapper estoppel limited to situations where there is a prior art rejection, have *de facto* overruled this Court's holding in the *Schriber-Schroth* case since they will never apply file-wrapper estoppel to a broadening amendment.

It is apparent that the limitation of the file-wrapper estoppel doctrine has ramifications far greater than the forum shopping dangers discussed by Petitioner, and Ford, as *amicus curiae*, respectfully urges this Court to grant certiorari to review and settle this issue.

---

1. *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 221 (1940).

CONCLUSION

For the reasons above stated, it is respectfully submitted that this Court should grant certiorari to resolve the conflict among the Circuit Courts of Appeal and should resolve this conflict by holding that file-wrapper estoppel is applicable to all changes in position taken in the Patent Office, not just those taken in response to a prior art rejection.

Respectfully submitted,

GEORGE N. HIBBEN
HIBBEN, NOYES & BICKNELL
332 South Michigan Avenue
Chicago, Illinois 60604

JOHN A. REILLY
KENYON & KENYON REILLY
CARR & CHAPIN
59 Maiden Lane
New York, New York 10038

Counsel for Petitioner

Of Counsel:

WILLIAM J. UNGVARSKY
EDWARD J. HANDLER, III
ARTHUR D. GRAY

LE COPY

OCT 10 1972

IN THE

Supreme Court of the United States

October Term, 1972.

No. 72-294.

L. GOLDSTEIN'S SONS, INC.,
Petitioner,

v.

TRIO PROCESS CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION.

THOMAS M. FERRILL, JR.,
Attorney for Respondent,
Suite 106 Towle Building,
1777 Walton Rd.,
Blue Bell, Penna. 19422.

Of Counsel:
ROGER NORMAN COE
ALLEN V. HAZELTINE

October 6, 1972.

Huntzinger Printing Corp., *Appellate Printers*, Camden, N. J.

TABLE OF CONTENTS

	PAGE
A. Opinions Below	1
B. Jurisdiction	1
C. The Questions Involved	1
D. Statutes and Regulations Involved	2
E. Statement of the Case	2
Argument	7
There Is No Merit in Any of the Reasons Urged By Petitioner for Granting the Writ	7
1. Re Petitioner's Point 1, There is No Split of Authority as to any Question Determinative of the Infringement Issue in the Present Case	7
2. Re Petitioner's Point 2, The Court of Appeals Applied the Established Law to the Facts Bearing on Validity as Shown by the Evidence	14
3. Re Petitioner's Point 3, The Court of Appeals Applied the Proper Test for Patentability of a Combination of Process Steps	18
4. Re Petitioner's Point 4, The Charges of Omission or Misrepresentation Are Groundless, and There Has Been No Error in Dismissing Those Charges	20
5. Re Petitioner's Point 5, The Holding of Willful Infringement is Not Error	21
Conclusion	24
Appendix: The Cases Relied On for Petitioner's Non-Accord Argument	A1

CITATIONS

CASES: PAGE

Ackermans v. General Motors Corp., 202 F. 2d 642 (4th Cir. 1953), cert. denied 345 U. S. 996 (1953) 19

Adamson v. Gilliland, 242 U. S. 350 (1916) 16

Bishman Mfg. Co. v. Stewart-Warner Corp., 380 F. 2d 336 (7th Cir. 1967), cert. denied 389 U. S. 897 (1967) A7, A8, A11

Borg Warner Corp. v. Paragon Gear Works, Inc., 355 F. 2d 400, 148 USPQ 1 (1 Cir. 1966), cert. dismissed 384 U. S. 935 (1966) 12, 13, A1

Bryson v. Clarke, 92 F. 2d 720 (CCPA, 1937) 10

Cantrell v. Wallick, 117 U. S. 689, 696 (1886) 16

Coffin v. Ogden, 18 Wall. 120 (1874) 16

Diamond Rubber Co. v. Consolidated Rubber Tire Company, 220 U. S. 438, 31 S. Ct. 444 (1910) .. 19

Eimco Corporation v. Peterson Filters & Engineering Co., 406 F. 2d 431 (10th Cir. 1968 & 1969), cert. denied 395 U. S. 963 (1969) 16, A10

Ellipse Corp. v. Ford Motor Company, 452 F. 2d 163 (7th Cir. 1971), cert. denied 92 S. Ct. 2041 (1972) A5, A6

Graham v. John Deere Co., 383 U. S. 1 (1966) 15, 16, 17, A10

Graver Tank & Mfg. Co. v. Linde Air Products, 339 U. S. 605 (1950) 8, 11, 12

Keating v. Stearnes Imperial Co., 347 F. 2d 444 (7th Cir. 1965) 12, 13, 14, A4, A5, A8, A11

In re Key, 76 F. 2d 398 (CCPA, 1935) 10

Kolene Corp. v. Motor City Metal Treating, Inc., 440 F. 2d 77, 82 (6th Cir. 1971), cert. denied 404 U. S. 836 (1971) 8, A4, A11

PAGE

Laitram Corp. v. Deepsouth Packing Corp., 443 F. 2d 928 (5th Cir. 1971) 12, 13, A2, A3

McCullough Tool Co. v. Well Surveys, Inc., 343 F. 2d 381 (10th Cir., 1965), cert. denied 383 U. S. 933 (1966) A1, A10

Moon v. Cabot Shops, Inc., 270 F. 2d 539 (9 Cir. 1959), cert. denied 361 U. S. 965 (1960) .. 12, 13, 16, A8, A9, A10

Mumm v. Jacob E. Decker & Sons, 301 U. S. 168, 171 (1937) 16

Norwood v. Ehrenreich Photo-Optical Indutries, Inc., et al., 322 F. Supp. 898; 168 USPQ 72 (D. C. C. D. Cal. 1971) 12, A9, A10

Otto v. Koppers Co., 246 F. 2d 789 (4th Cir. 1957), cert. denied 355 U. S. 939 (1958) 17

Parke, Davis & Co. v. American Cyanamid Co., 207 F. 2d 571 (6th Cir. 1953) 12, 13, A1, A3, A4, A11

Powder Power Tool Corp. v. Powder Actuated Tool Co., 230 F. 2d 409 (7th Cir. 1956) A8, A11

Power Curbers v. Etnyre & Co., 298 F. 2d 484, 132 USPQ 158 (4th Cir. 1962) 12, 13, 17, A2

Radio Corporation of America v. Radio Engineering Laboratories, 293 U. S. 1 (1934) 16

Schmidinger v. Welsh, 383 F. 2d 455 (3rd Cir. 1967), cert. denied 390 U. S. 946 (1968) 16, A10

Sears Roebuck & Co. v. Jones, 308 F. 2d 705 (10th Cir. 1962), cert. denied 371 U. S. 952 (1963) ... A10

Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co., 143 U. S. 275 (1892) 16

Williams Bit & Tool Co. v. Christensen Diamond Products Co., 399 F. 2d 628 (5th Cir. 1968) 8

PAGE

Unilectric, Inc. v. Holwin Corp., 243 F. 2d 393, 398 (7th Cir. 1957), cert. denied 355 U. S. 830 (1957) A5, A11

STATUTES:

Title 35 U. S. Code 103 6

Title 35 U. S. Code 282 15

RULES OF THE SUPREME COURT OF THE UNITED STATES:

Rule 21 2

OTHER CITATION:

Rules of Practice of United States Patent Office:

Rule 75(d) 8, 10, 13, 14

BRIEF FOR RESPONDENT IN OPPOSITION.

A. OPINIONS BELOW.

The District Court's opinion, dated January 27, 1971, is reproduced on pages 1a-14a of petitioner's appendix.

The Court of Appeals' opinion, filed May 22, 1972, is reproduced on pages 15a-30a of petitioner's appendix, and the Opinion Sur Petition for Rehearing is on pages 31a-32a thereof.

B. JURISDICTION.

Petitioner has correctly stated the basis for jurisdiction.

C. THE QUESTIONS INVOLVED.

Petitioner's statement of the questions involved is hardly appropriate, because it intermixes hypotheses and argument with the ultimate questions. Respondent submits here a succinct counterstatement of the questions, the facts and argument being relegated to the subsequent parts of this brief:

Was the Court of Appeals correct in its holdings:

1. That respondent's patent No. 3,076,421 is valid;
2. That the alleged omissions or misrepresentations were not material;
3. That petitioner has infringed the patent; and
4. That such infringement was willful?

D. STATUTES AND REGULATIONS INVOLVED.

Petitioner has correctly cited certain sections of Title 35, U. S. Code and the pertinent rule from the Rules of Practice of the U. S. Patent Office.

E. STATEMENT OF THE CASE.

The statement of the case on pages 8-10 of the Petition is distorted and argumentative.* Respondent therefore submits the following counter-statement.

Petitioner is seeking to have the Supreme Court review the decision for plaintiff-respondent in a suit for willful infringement of respondent's Spitz Patent 3,076,421 issued February 5, 1963. That patent describes and claims a new, advantageous process for the recovery of the metal content of scrap electrical wire (generally copper, worth approximately $.50 per pound).

Spitz's patented process is an inversion of the prior technique in recovery of the copper from scrap electrical wire. Before his invention, aside from the inefficient, unsatisfactorily controlled and virtually abandoned open-field burning of scrap wire, the prevailing technique involved rapid burning at very high temperature in a stationary furnace with refractory lining. The scrap wire had to be either baled or placed in a basket, transported, injected into the intensely hot interior of the fixed refractory furnace where it was kept for a period of about one hour, and then extracted, to be followed by introducing a further charge of basketed or baled scrap wire.

---

* Petitioner elected not to have the record or any portion thereof certified and transmitted. Pursuant to Rule 21, respondent has brought about the certification and transmission of the Final Pre-Trial Order and those trial record pages and exhibits which are referred to herein.

Spitz invented a process which was opposite to the prior art. He burned the wire under conditions of very limited air intake and used air cooling, resulting in a slow, low-temperature burning, and oxidation was suppressed for best metal preservation. He used a movable furnace with unlined conical shell, superimposing it over the pile of wire scrap which was burned *in situ*. He arranged for after-burner treatment of the effluent gases and gas-entrained materials, the afterburner being integral with the furnace shell and directly above the encased scrap pile.*

The U. S. Patent Office found Spitz's method, as distinguished from the apparatus, patentable.

From a time long prior to Spitz's invention, petitioner had been a major reclaimer of copper from scrap. It had made use of open-field burning, and had made use of a stationary refractory-lined furnace. Neither was satisfactory. Upon seeing Spitz's process being practiced by respondent's first licensee, petitioner became intent upon finding some way to obtain corresponding benefits for itself in the recovery of copper. It tried, without success, to have some competing system developed. It also called on an attorney to estimate whether or not a patent should be obtainable on Spitz's furnace (the unit itself) based on petitioner's sketch of its external appearance. The attorney's response expressed doubt that a patent would be granted on the unit, or would be valid if granted. Even assuming that petitioner may have gleaned some knowledge of Spitz's process from observation or otherwise, petitioner did not

---

* As the Court of Appeals observed, Spitz

". . . finally developed a concept converse to that previously employed, namely, the burning of the insulation in a portable furnace at a low temperature to be controlled by limiting the availability of air. Spitz's development had several advantages over the prior procedures: it reduced materials handling costs, it diminished air pollution, and it efficiently produced No. 1 grade copper scrap inexpensively by a method which could be operated by relatively untrained personnel."

(Petitioner's app. 17a-18a).

ask for, much less obtain, an estimate (an opinion) as to the prospect of obtaining a valid patent on that process.

The fact that it had obtained a preliminary opinion on the question of apparatus patentability did not deter petitioner from coming to respondent at the beginning of 1960 to obtain a furnace and acquire a license for the practice of respondent's advantageous process. After using that process for a few months with its first furnace, petitioner obtained from respondent another furnace and acquired a license for using that furnace also in Spitz's reclamation process.*

Later, when the Spitz patent issued in February, 1963 with its claims to his process, petitioner then had the opportunity to present a copy of that patent to its lawyer and obtain a meaningful opinion—an opinion on the patent itself. But petitioner did not do so.

About a year later, petitioner deliberately embarked on a campaign to have the movable furnace units copied and to expand its exploitation of the process in violation of respondent's patent rights (petitioner's appendix 2a, 3a, 30a). Petitioner proceeded surreptitiously. When respondent inquired as to whether petitioner would be interested in using further units, petitioner falsely represented that there were reasons why it could not do so, despite the fact that petitioner even then had arranged for the proliferation

---

* On page 9 of the petition (and on page 3 by implication), a claim is made, without citation of support, that petitioner developed the process it uses. The speciousness of this claim is apparent from the following two paragraphs quoted from The Final Pretrial Order, stipulated by the parties March 26, 1969, and certified and transmitted to the Court:

> "6. Prior to the purchase of its first incinerator from the plaintiff, the defendant had never invented, obtained, operated or used similar portable insulation burning apparatus or practiced a method of burning insulation with such apparatus.
>
> "7. The plaintiff assisted the defendant in setting up its first portable incinerator and instructed the defendant in the method of removing insulation using the portable incinerator which was furnished pursuant to the license agreement of January 2, 1960. In addition, on behalf of the defendant the plaintiff applied for and obtained appropriate permits from the City of Philadelphia for the erection and use of the incinerator."

of its furnaces and expansion of its use of respondent's patented method by unauthorized copying.*

As the District Court correctly stated, "Patent '421 as issued contains claims 14 through 17 renumbered to be claims 1 through 4. At issue in this litigation are claims 1, 3 and 4." (petitioner's app. 5a; claims 1, 3 and 4 being reproduced at 12a-14a thereof). Pages 8-9 of the petition present misinformation concerning Spitz's application claims 14-17 which, after rejection and amendment, became claims 1-4 of the patent. Petitioner's incorrect version (Pet. p. 9) is that these four application claims, when presented Sept. 8, 1960, all recited superimposing the incinerator unit before igniting the pile, were rejected on that ground, were amended to state those steps in the order set forth in the specification, and were then allowed. This was true as to claims 16 and 17 which became patent claims 3 and 4; it was not true as to claims 14 and 15 which became patent claims 1 and 2 (petitioner's app. 4a, 12a).** On page 11, petitioner sets forth misrepresentations as follows:

> "In the opinion of the Court of Appeals below [App. 29a], the Court acknowledged that respondent's earliest versions of proposed method claims 14-17 attempted to invert the order of steps 1 and 2 of the patented process, . . . The Court states [App. 29a] that respondent **could** recapture the attempted broadened scope of proposed claims 14-17. . . ."

Contrary to these self-serving imputations of petitioner, the Court of Appeals neither specified which claims it was here referring to, nor "acknowledged" what petitioner avers. The

---

* Pages 231-233 of the trial transcript.

** On pages 740-741 of the trial transcript, petitioner's expert Levin acknowledged that claim 1 does not call for superimposing the chamber, and that the question of a different recited order of steps from petitioner's steps does not arise.

The history of application claims 14-17, inclusive, is traced in the file wrapper, plaintiff's Exhibit 1-B, through pages 41-48, 50-51, 59-62, 65, 68-71 and 73.

Court's remarks here could only be applicable to claims 16 and 17—not 14 and 15, which never recited a superimposing step. And finally, the Court did **not** state that respondent could "recapture" anything, or say anything about "attempted broadened scope"—this is petitioner's argumentative matter, not something stated by the Court of Appeals. No matter how desperately petitioner needed to relate its alleged file wrapper estoppel argument to claim 1 as well as claims 3 and 4 of the patent, it should have made it clear that in application claim 14 or the resultant patent claim 1, there never was a recitation of superimposing the incinerator, much less a rejection and amendment to change the order of occurrence of superimposing.

The District Court found that the claims of the Spitz patent (if valid) were willfully infringed by petitioner. After giving consideration to petitioner's arguments on its cross appeal with respect to willful infringement, the Court of Appeals for the Third Circuit affirmed that holding.

The District Court, upon considering the aggregate of 12 prior art references (9 patents and 3 articles) relied upon by petitioner, had held the claims of the Spitz patent invalid as obvious under 35 U. S. Code §103. The Court of Appeals gave careful consideration to the prior art and to the District Court's opinion, and reversed, holding the patent valid. The Court of Appeals stated that

> ". . . the essence of the Spitz invention did not lie in the individual steps, but rather, consisted of combining the steps in an unsuggested manner into a process that would achieve a substantially different function and result from the other processes of which the individual stages were a part,"

the invention of the process being patentable even if the individual phases were known in the art (petitioner's app. 25a).

ARGUMENT.

F. THERE IS NO MERIT IN ANY OF THE REASONS URGED BY PETITIONER FOR GRANTING THE WRIT.

Petitioner has advanced five reasons in support of its petition for a writ of *certiorari*. As will be demonstrated, each of these alleged reasons is without merit, and hence the petition for *certiorari* should be denied.

This case presents nothing more than the application of well settled principles to a dispute between the parties as to whether plaintiff-respondent is entitled to relief for willful infringement of its patent.

1. Re Petitioner's Point 1, There is No Split of Authority as to Any Question Determinative of the Infringement Issue in the Present Case.

Despite petitioner's efforts to create the opposite impression, no unresolved question of patent law is here presented for determination. Petitioner on pages 11-17 tries to paint a picture of opposite views "among the various circuits as to whether a patentee may assert against an infringer a broadened interpretation of patent claims which have been **narrowed** in response [to] a rejection by the Patent Office on grounds other than prior art." (From petitioner's heading on page 11, emphasis added.)

There are three reasons why the affirmed holding of infringement in the case *sub judice* is not dependent on law as to which there is divergence among the various circuits. These three reasons are:

(a) One of the three patent claims in suit (claim 1) is literally infringed by petitioner's practice of the wire rec-

lamation process. Hence, even if there were a file wrapper estoppel which could circumscribe the doctrine of equivalents with respect to claims 3 and 4, that would be no basis for a holding of non-infringement of the Spitz patent.

(b) Petitioner's above-quoted proposition cannot even be applicable to claims 3 and 4, since they were not broad claims, narrowed down during prosecution, but rather they originated as **specific** claims which were deemed not to meet the specific conformance requirements of Patent Office Rule 75(d).

(c) From a scrutiny of the law of the six circuits selected by petitioner, including the cases petitioner cites as suggesting the broadest applications of file wrapper estoppel, it does not appear that any of those Courts would reach a result different from the affirmed holding of infringement upon the present facts.

As to the first-enumerated reason, petitioner failed to point out that since claim 1 is literally infringed, it does not even involve the doctrine of equivalents, much less the question whether that doctrine is circumscribed by a file wrapper estoppel. *Graver Tank & Mfg. Co. Inc. et al. v. Linde Air Products Co.* (on rehearing), 339 U. S. 605, 607 (1950); *Williams Bit & Tool Co. v. Christensen Diamond Products Co.*, 399 F. 2d 628, 634 (5th Cir. 1968); *Kolene Corp. v. Motor City Metal Treating, Inc.*, 440 F. 2d 77, 82 (6th Cir. 1971), cert. denied 404 U. S. 886 (1971). Petitioner's expert Levin admitted that the "step of superimposing the chamber on the wire is not in claim 1 specifically", and agreed that claim 1 does not call for the process steps being in different order from the way petitioner uses the process.* He had no alternative but to agree, since the limiting of the air admission rate always is in the claimed order, being estab-

* Pages 740-741 of the trial transcript (supra, p. 5).

lished after the wire pile has been ignited. The unit is lowered the rest of the way to the ground (if used without closable apertures), or the aperture doors are closed to limit the air after igniting.

As pointed out in the counterstatement of the case, the petitioner erroneously proceeds as though all four of application claims 14-17 had recited superimposition of the bottomless enclosing chamber after igniting, and were rejected on that ground and amended. But claims 14 and 15, which after amendment became claims 1 and 2 of the patent, never recited the superimposition, and never required any amendment as to its order (*supra*, p. 5; petitioner's app. 4a, finding of fact No. 19, last sentence).

With respect to the second of the above-enumerated reasons, claims 3 and 4 of the patent never were narrowed down. These claims originated as specific claims Nos. 16 and 17 of the application, first introduced by amendment on September 8, 1960. In these two claims as they were worded when first tendered, the igniting of the scrap pile was recited after the superimposing of the bottomless pile-enclosing chamber. The specification had not mentioned performing the superimposing and lighting in this order, even though it had set forth an alternative construction of the apparatus having apertures provided in the cone, with suitable closure means.*

---

*As was brought out at the trial, one can kindle and ignite the pile through such a closable aperture, just as readily as he can kindle and ignite the bottom of the pile while the suspended furnace unit is poised just above, the lowering of the unit the last incremental distance to the ground occurring after ignition. (Pages 208-09 and 278 of the trial transcript.) Petitioner suggests on page 9, contrary to the credible evidence, that until the pile is well ignited, it receives a rush of air and temporary smoking results only if the unit is suspended just above the ground, no such thing occurring if it is already on the ground and the wire pile is lighted through the doors.

Under the Patent Office's Rule 75(d) the Examiner had to reject these two claims which he deemed to be **specific** to a sequence **not expressly described.** Rule 75(d) as it has appeared in each version of the Rules of Practice of the United States Patent Office, from the March 1, 1949 issue to the present date, is as follows:

> "(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."*

This rule prevents the obtaining of a claim to an apparatus or a process which, even if an obvious equivalent of what is shown and described in the specification, is not in every respect in conformity with (i.e., specifically supported by) the specification. *In re Key*, 76 F. 2d 398, 400 (CCPA, 1935); *Bryson v. Clarke*, 92 F. 2d 720, 724-25 (CCPA 1937). In these cases, the Court explained that whereas the doctrine of equivalents is applicable in an infringement case, it does not confer upon an applicant the right to obtain in his patent claims drawn to equivalent versions to those described in his specification.

As the Court of Appeals recognized in rejecting the file wrapper estoppel contention and affirming the trial court's holding of willful infringement of the Spitz patent,

> "Here, the claims were redrafted, not because they trespassed upon the prior art, but because they were considered misdescriptive in view of the specification of the patent. The rejection here was a technical matter based on the Rules of Practice of the Patent Office,

---

In fact, in either case, ample air ingress is permitted until the material is well ignited, e.g. by keeping all the doors open for this purpose if the unit is already on the ground (page 44 of the trial transcript).

*** After the Examiner rejected claims 16 and 17 of the application, they were amended to be consistent with the order of steps as described.**

and had nothing to do with the question whether the matter rejected was patentable. In such a situation, it would not be equitable to deprive a patentee of the full fruits of his invention because of a formalistic rule of the Patent Office. See Peterson Filters & Engineering Co. v. Eimco Corp., 155 USPQ 89 (D. Utah, 1967) *aff'd* 406 F. 2d 431, 438 (10th Cir. 1968)."

(Petitioner's app. 29a-30a).

The process flagrantly practiced without license by petitioner not only is literally in accordance with claim 1 of the patent but is the equivalent of the process described and claimed by claims 3 and 4 as well. Defendant's expert Levin acknowledged that a departure from the order of recitation of claimed steps would not avoid infringement of the Spitz patent claims unless the exact sequence of steps is an important part of the patented process.* It is not important whether the igniting precedes the superimposing of the pile enclosing chamber—it is more convenient to light the pile through the apertures (after lowering), if such are provided.**

Therefore, it was proper for the District Court to hold that the claims are infringed, and for the Court of Appeals to affirm that holding.

In *Graver Tank & Mfg. Co. v. Linde Air Products*, 339 U. S. 605, 607-08 (1950), this Court made it plain that "the unscrupulous copyist" shall not be permitted to "pirate an invention" merely by relying upon "minor variations to conceal and shelter the piracy." The Court further stated:

> "The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. . . . 'To temper unsparing logic and prevent an infringer from stealing the benefit of the invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same func-

---

* Pages 739-40 of the trial transcript.

** Pages 208-09, 278 and 339 of the trial transcript.

tion in substantially the same way to obtain the same result.'" (339 U. S. at 608).

In view of the immateriality whether the pile of wire scrap for reclamation is ignited just before the bottomless chamber has been lowered all the way to the ground, or is lighted just afterward through closeable apertures in the cone, the limitation of admitted air being effected thereafter in either case by lowering the chamber to the ground or by closing the doors, petitioner shows extreme hardihood in its strained efforts to escape the consequence of its piracy of Spitz's meritorious invention on this flimsy ground.

Referring to the aforesaid third reason Contrary to what petitioner implies, there is not a split of authority among the circuits as to a matter on which the correctness of the concurrent holdings of infringement below would depend—not even as to claims 3 and 4 of the patent, as to which the doctrine of equivalents is invoked.

Attention is now turned to the cases petitioner cited from the First, Fourth through Seventh, and Ninth Circuits in its attempt to demonstrate a divergence of opinion tending to aid petitioner [as to claims 3 and 4 to which the doctrine of equivalents applies].* Scrutiny of these and additional cases shows that they do not stand for the proposition which would be of some avail to petitioner as to those two claims. That proposition, inconsistent with the law, is that the presentation, rejection, and cancellation (or amend-

---

* Petitioner's seven cases on which it argues a lack of accord with the Third Circuit (inter alia), are:

Borg Warner Corp. v. Paragon Gear Works, Inc., 355 F. 2d 400, (1 Cir. 1966), cert. dismissed 384 U. S. 935 (1966);

Power Curbers v. Etnyre & Co., 298 F. 2d 484 (4th Cir. 1962);

Laitram Corp. v. Deepsouth Packing Corp., 443 F. 2d 928 (5th Cir. 1971);

Parke, Davis and Co. v. American Cyanamid Co., 207 F. 2d 571 (6th Cir. 1953);

Keating v. Stearnes Imperial Co., 347 F. 2d 444 (7th Cir. 1965);

Moon v. Cabot Shops, Inc., 270 F. 2d 539 (9th Cir. 1959), cert. denied 361 U. S. 965 (1960); and

Norwood v. Ehrenreich Photo-Optical Industries, Inc., et al., 322 F. Supp. 898; 168 USPQ 72 (C. D. Cal. 1971).

ment) of claims specific to a process or an embodiment not explicitly described in the patent application and hence ruled out by Patent Office Rule 75(d) will, under a theory akin to the doctrine of file wrapper estoppel, deprive the patentee of the benefit of the doctrine of equivalents for protection against one who, though not literally infringing a patent claim, does the same things in substantially the same way and produces substantially the same result, the principle and mode of operation of the patent being appropriated for the purpose.

In order to avoid over-burdening this brief with analyses of petitioner's cases purportedly not in accord with the law applied in the Third Circuit, those cases, along with a few additional cases for comparison, are discussed in the Appendix hereto.

To summarize the cases on which petitioner purports to rely, in the *Power Curbers* and *Parke, Davis* cases (A2 and A3) the Courts were presented with compelling reasons why there was no equivalence in fact between what was claimed in the narrowed-down claims and the accused products; hence, the claims were not infringed. In the *Borg Warner and Laitram* cases (A1 and A2), the Courts expressed the view that file wrapper estoppel could arise upon claims being narrowed down for various reasons, and yet, while recognizing that the claims there involved had been narrowed by amendment for greater definiteness, the Courts accorded the claims involved in these cited cases a range of equivalents at least as broad as accorded respondent's claims 3 and 4, resulting in the holdings of infringement in the cited cases. The *Moon* case (Ninth Circuit) and the *Norwood* case in the Central District of California (A8 and A9) both involve claims which were narrowed down in view of the prior art (Norwood himself being the prior patentee in the latter case), and hence these two cases, also, do not exemplify any such divergence of holdings as petitioner would imply. The *Keating* case (A4) so clearly involved withdrawing the several original broad claims in favor of limited narrow claims,

along with Keating's own self-contradictions in his specification and his stipulation (347 F. 2d at 448), as to compel the resultant holding and affirmance of non-infringement.

It is clear from these cases that the determination whether the concurrent holdings of infringement in the present case are correct does not depend on resolving a point of law on which the various Circuit Courts of Appeals may be divided. As stated, neither the doctrine of equivalents nor the question of file wrapper estoppel was involved with respect to Spitz's claim 1 which is literally infringed (*supra*, pp. 5 & 9). As to claims 3 and 4, to which the doctrine of equivalents applies, none of the cases cited would stand as a precedent for reaching the opposite result on the issue of infringement upon the present facts. Spitz's claims 3 and 4 started out as **specific** claims (application claims 16 and 17). Since they never were broad, generic claims, they were not narrowed down to avoid prior art or for any other reason. Rather, the Examiner simply required compliance with Patent Office Rule 75(d) which precludes obtaining claims to equivalents (*supra*, pp. 10-11). And since the defendant-petitioner, a deliberate copyist from plaintiff, not only literally infringes claim 1 but practices essentially the same process of metal reclamation to produce the same result in substantially the same way and by substantially the same steps as in claims 3 and 4, it infringes all three asserted claims of the Spitz patent.

2. Re Petitioner's Point 2, The Court of Appeals Applied the Established Law to the Facts Bearing on Validity as Shown by the Evidence.

On pages 17 and 18, petitioner argues that in holding the Spitz patent valid, the Court of Appeals overlooked proof of a prior use of low-temperature burning of insulation by American Smelting Company, and erred in not deeming the "clear and convincing" standard of proof for over-

coming the presumption of validity (35 U. S. C. 282) to have been nullified by this Court's decision in *Graham v. John Deere Co.*, 383 U. S. 1 (1966). For these contentions, petitioner takes liberties with the facts and the law. As to the facts, petitioner states on page 18,

> "Although the Court erroneously indicated [App. 24a] that the prior art did not show low-temperature burning of the insulation from wire scrap, it did not even mention, let alone consider, the scrap copper wire reclamation procedures of the American Smelting and Refining Co. mentioned in the trial court's Findings of Fact [App. 2a]. This finding acknowledges that there was, before the present invention, a commercial wire reclamation process including a second-stage afterburner chamber for burning insulation off of wire. **The trial record clearly revealed that the primary combustion chamber was a low-temperature burning chamber since the amount of air to it was limited.**" (Emphasis added.)

Directly to the contrary, the trial record revealed that American Smelting's primary combustion chambers (twin chambers, for alternate loading) operated at **intense heat**, as follows:

> . . ."They were refractory lined and in my opinion while they burnt the wire they were completely unsatisfactory.
>
> "The operator had to load them with a fork truck and the material had to be placed in a stainless steel sort of a basket or pallet. **The refractory stayed red hot and as soon as the fork-truck operator got within range of the thing, the copper, the insulation, started to burn. He had to quickly put it in, put it down and get out before the whole thing caught fire.**
>
> "Then they had to leave it in perhaps an hour, an hour and a half, or some time, I don't remember ex-

actly; then come and get it, **at which time the refractories were almost white hot. . . ."*** (Emphasis added.)

Concerning the law, petitioner has not cited any case in which this Court (or any other court) has declared at an end the law that the presumption of validity of a patent can be overcome only by clear and convincing proof. The standard of proof has not changed. *Coffin v. Ogden*, 18 Wall. 120, 124 (1874); *Cantrell v. Wallick*, 117 U. S. 689, 696 (1886); *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co.*, 143 U. S. 275, 284-85 (1892); *Adamson v. Gilliland*, 242 U. S. 350, 353 (1916); *Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 8 (1934); *Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 171 (1937); *Moon v. Cabot Shops, Inc.*, 270 F. 2d 539, 540 (9th Cir. 1959), cert. denied 361 U. S. 965 (1960); *Schmidinger v. Welsh*, 383 F. 2d 455, 462 (3rd Cir. 1967), cert. denied 390 U. S. 946 (1968); *Eimco Corporation v. Peterson Filters & Engineering Co.*, 406 F. 2d 431, 434 (10th Cir. 1968 & 1969), cert. denied 395 U. S. 963 (1969).

Petitioner attempts in vain to read into this Court's opinion in *Graham v. John Deere Co.*, 383 U. S. 1 (1966), an implication that a different standard of proof will henceforth apply. That attempt is defeated by the Court's own words. At page 17, the Court explained,

> "We believe that this legislative history, as well as other sources, shows that the revision was not intended by Congress to change the general level of patentable invention. We conclude that the section was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with Congressional directions that inquiries into the obviousness of the sub-

---

* Pages 200-201 of the trial transcript. On pages 297-98 of the trial transcript, Spitz, under cross-examination, accepted a characterization of the air intake to the furnace at American Smelting Company as "somewhat limited". This does not detract from or contradict his testimony quoted above.

ject matter sought to be patented are a prerequisite to patentability."

And further, at page 19, the Court stated,

"Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of Section 103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. . . . The standard has remained invariable in this court. . . ."

Since petitioner cannot succeed in reading into the *Graham* decision a change of the legal standard (which the Court explicitly ruled out), petitioner is relegated to urging this Court on page 18 "to make a fresh inquiry as to the vitality and application of" the pertinent rules and decisions. But the obvious motivation for urging the Court to review this case is petitioner's grim determination to escape the consequences of its deliberate, determined piracy of respondent's meritorious invention.

The presumption of validity of a patent is especially strong where, as in the present case, any prior art relied on by an accused infringer is merely cumulative with prior art cited by the Examiner. *Power Curbers, Inc. v. E. D. Etnyre & Co.*, 298 F. 2d 484, 493 (4th Cir. 1962); *Otto v. Koppers Co.*, 246 F. 2d 789, 801 (4th Cir. 1957), cert. denied 355 U. S. 939 (1958). Five of the nine patents relied on by petitioner had been cited by the Examiner in the Patent Office. The District Court observed in its opinion that the four additional patents relied on by petitioner added nothing to the previously cited patents (petitioner's app. 8a). That Court made no explicit holding as to whether or not the three additional publications relied on by petitioner were also merely cumulative. The Court of Appeals, however, stated in its opinion,

"A careful reading of the patents and literature reference cited by Goldstein indicates that they are merely cumulative to the references before the examiner. As such, they add no new material from which

> the district court could conclude that had the examiner read them, he would have held that the invention was unpatentable for obviousness. None of the references cited by the district court, individually or taken as a whole, indicate that organic insulation can be burned in a commercially feasible manner from scrap wire at low temperature without oxidizing or melting the wire."
>
> (Petitioner's App. 24a).

Thus, contrary to the second point in petitioner's argument, the Court of Appeals was cognizant of the facts, and it correctly applied the established law.

3. Re Petitioner's Point 3. The Court of Appeals Applied the Proper Test for Patentability of a Combination of Process Steps.

On pages 19-20, petitioner presents its third argument in support of its petition, i.e., that the Court of Appeals for the Third Circuit did not understand how to apply the law to a claimed process comprising a combination of steps. Here, petitioner has the hardihood to rely again on misstating the facts as to the American Smelting Company's reclamation procedure, characterizing that company's wire-burning chamber as a "low temperature" chamber, and asserting, in the face of the record to the contrary, "The only difference in the process is that the patentee brings his incinerator to the scrap rather than vice versa." Even the initial premise is fallacious (*supra*, pp. 15-16). The interior temperature of American Smelting's refractory chamber was so great that the new charge of wire was catching fire even as the fork-lift truck operator brought it to the proximity of the open 6-foot by 6-foot door. And later, as the operator was extracting the charge of wire by the use of his fork-truck, after about an hour of intense burning, the refractory lining was almost white hot (*supra*,

p. 16). In addition, even if its temperature could have been drastically reduced, that American Smelting structure could not have been superimposed upon piles of scrap. Spitz's process consisting of his new combination of steps not only provided a great improvement in production economy (petitioner's app. 17a and 25a), but also, it accomplished maximum yield of high-grade copper in contrast to the copper loss with the prior processes. Petitioner gave it "the tribute of its imitation" (*Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 438, 31 S. Ct. 444, 450 (1910); *Ackermans v. General Motors Corp.*, 202 F. 2d 642, 645 (4th Cir. 1943), cert. denied 345 U. S. 996 (1953)), and moreover, petitioner publicly boasted of the greater metal conservation realized with this process, pointing out that this justified the selection of petitioner over other scrap reclaimers by concerns with available scrap wire who would be seeking maximum return from their supply. Plaintiff's exhibits 33, 34 and 35 are examples of petitioner's prominent advertisements extolling the advantages of this system. For instance, in plaintiff's exhibit 35, a box advertisement in the issue of American Metal Market of August 9, 1965, petitioner boasts, in reference to this process:

IT'S NOT EASY
TO BURN INSULATED
COPPER WIRE

But We Do It With
Thermo-Controlled Furnaces
And Recover EVERY POUND Of Copper.

And in plaintiff's exhibit 33, in a large two-page center-fold spread advertisement of the special March 19, 1965 issue of American Metal Market, alongside a 10-inch by 13-inch photo of the funnel-shaped furnaces being used at petitioner's main plant for practicing the Spitz process, petitioner further praised the system as follows:

Missiles?

Not at all! They're furnaces which burn off all the insulation from your wire and you end up with 100%

> of the copper content which went in. That's really great when you consider that it's your money we're not burning up!*

Petitioner's recognition of the outstanding performance provided by Spitz's process is shown by its own actions, e.g., by its rejection of its attempted substitute processes, by its advertisements (as exemplified above), and by its recommendation of the process to its European counterpart (*infra*, p. 23). The opinion of the Court of Appeals shows its correct understanding that this outstanding benefit results from the process as a whole (petitioner's app. 24a-25a), a process converse to the prior art (petitioner's app. 17a). The evidence in this case does not show this converse process to have been obvious to persons of ordinary skill in the art; to the contrary, it supports the Court's holding of patentability.

4. Re Petitioner's Point 4. The Charges of Omission and Misrepresentation Are Groundless, and There has been No Error In Dismissing Those Charges.

On pages 20-21, petitioner fails to make it clear that it was never held that petitioner had sustained its burden of proof during the trial of the criticisms which it **alleged** before the District Court and realleged before the Court of Appeals. Neither Court held that the evidence supported petitioner's allegations of omission and misrepresentation. Petitioner tenders its appendix page 26a as support for its charges. But this excerpt from the Opinion of the Court of Appeals does not speak in terms of what the evidence establishes, or even tends to show; rather, it deals with what pe-

---

* Plaintiff's Exhibits 33, 34 and 35 and related pages 52-55 of the trial transcript.

titioner **"contends"**, and petitioner's **"allegations** of omissions and misrepresentations" (emphasis added).

These flailing charges had no such merit as to deserve any findings or discussion by the District Court, and they received none. The Court of Appeals dismissed these flimsy allegations in view of their failure to go to matters determinative of the issues, stating, ". . . we hold that, on the facts of this case, such were not material, . . ." (petitioner's app. 26a). The Court of Appeals did not stop there, but went further, holding, on the basis of "a review of the record as a whole", that petitioner did not sustain its burden of proof that the specification fails to teach a person skilled in the art how to operate the process (petitioner's app. 27a).

5. Re Petitioner's Point 5, the Holding of Willful Infringement is Not Error.

Petitioner seems unable [or perhaps unwilling] to present for this Court's consideration a fair and accurate version of the holdings below. The final instance is petitioner's statement on pages 21-22 that the Court of Appeals "supported the finding by the district court of willful infringement by alluding to the fact that petitioner sent blueprints of the respondent's incinerator abroad." What the Court **did** say was:

> "Goldstein next asserts that even if it were held to be an infringer, such infringement was not willful because it sought the advice of patent counsel as to the patentability of Spitz's invention. However, the **opinion of counsel was not sought after the patent issued,** even though more than a year elapsed after issuance before Goldstein began to infringe. **This alone is enough to support a conclusion of willfulness.** Maxon Premix Burner Co. v. Mid-Continent Metal Prods. Co., 270 [sic; 279] F. Supp. 164 (N. D. Ill., 1967), and **when viewed in conjunction with the totality of Goldstein's**

> **actions,** including sending blueprints and operating instructions to a foreign company, we cannot say that the trial court's conclusion in this regard was erroneous."* (petitioner's app. 30a, emphasis added.)

What petitioner understandably is reluctant to discuss is the "totality of Goldstein's actions" which reinforce the affirmed holding of willful infringement. Among petitioner's actions undoubtedly included in the "totality" taken into consideration by the Court are the following:

> (1) Petitioner, having tried with the aid of others to find some way to gain benefits comparable with those of Spitz's development, resigned itself by late 1959 to the fact that it must have the use of the Spitz development. (petitioner's app. 2a-3a).
>
> (2) In late 1959, petitioner obtained an attorney's prediction of unlikely patentability of Spitz's furnace unit. Notwithstanding that prediction, petitioner went ahead in early 1960 with acquisition of a first furnace, and a license from respondent to operate that furnace, and after trying out the process, it acquired a second furnace and license (petitioner's app. 3a).
>
> (3) After the Spitz patent on the wire reclamation method issued February 5, 1963, petitioner did not seek an opinion of counsel as to the validity of that process patent. (petitioner's app. 3a).
>
> (4) From October 1964 on, petitioner deliberately proceeded in its campaign to duplicate Spitz's process, by having the furnaces for which it was licensed copied, and greatly expanding its use of the process in violation

---

* Petitioner argues on page 22 that this is the first case "in which a court has required **two** opinions from counsel to a layman" in assessing the willfulness of his infringement. This is not what the Court said. Regardless of whether petitioner obtained a pre-patent prediction as to prospective patentability of a furnace which it sketched in plaintiff's exhibit P108 (the opinion on which petitioner chose not to rely), its defiance of the issued patent on the reclamation **process** without even obtaining an opinion of counsel on that patent was what was significant.

of respondent's Spitz patent (Paragraphs 14 and 15 of the Final Pre-trial Order).

(5) Petitioner falsely represented to respondent that it would not be in a position to expand its use of the patented process, even while it was surreptitiously and unlawfully doing so; and when its ruse was uncovered, petitioner invited Mr. Spitz to go jump in the lake, or "words to that effect" (pages 231-233 of the trial transcript).

(6) Petitioner acquired AMA Metal Corporation of Oceanside, New York on February 1, 1965, at which time that company was already a licensee of respondent with one furnace in authorized use. Within the next month, petitioner proceeded to expand the facilities at that company, and bring about expanded use of Spitz's process in violation of respondent's rights. (petitioner's app. 3a).

(7) In its advertising, petitioner prominently played up the superiority of the process, without crediting Spitz with its development or giving recognition in any way to respondent's Spitz patent. Petitioner also brought about the duplication of the process by a company in Belgium, on the basis of petitioner's instructions, without disclosing the fact that the process had been originated by Spitz—not by petitioner (*supra*, pp. 19-20).

(8) In the course of his testimony under oath during the trial, petitioner's president, Irving Schorsch, persistently evaded forthright acknowledgment of the extent of his company's proliferation of furnaces for the Spitz patented process, evoking the following warning:

"The Court: Mr. Schorsch, I remind you that you are under oath and this is a serious matter.

"The Witness: I understand that, sir.

"The Court: I am suggesting that you carefully consider some of these answers you have been giving, which impress me as being utterly incredible." (page

142 of the trial transcript; see also pages 231-33 of the transcript).

Considering the "totality of Goldstein's actions", including the above-mentioned items, *inter alia*, it is hardly surprising that the Court of Appeals affirmed the District Court's holding that the infringement was willful, even without having the lower Court's benefit of observing the demeanor at the trial of petitioner's executives and witnesses called on its behalf.

Closing its argument against the affirmed holding of willful infringement (page 23), petitioner urges that absence of "**literally** infringed" claims should have ruled out the holding of willfulness (petitioner's emphasis). Even that argument is groundless, since there is not only substantial following of claims 3 and 4 but literal infringement of claim 1 (*supra*, pp. 5 & 9).

CONCLUSION.

Petitioner has strained to reshape the facts and the law and thereby gain a yet further appellate review of a straightforward patent infringement case, as here demonstrated. For the above reasons, the petition should be denied.

Respectfully submitted,

THOMAS M. FERRILL, JR.,
Attorney for Respondent,
Suite 106 Towle Bldg.,
1777 Walton Rd.,
Blue Bell, Penna. 19422

Of Counsel:
ROGER NORMAN COE
ALLEN V. HAZELTINE

APPENDIX.

The Cases Relied On For Petitioner's Non-Accord Argument.

Borg Warner Corp. v. Paragon Gear Works, Inc., 355 F. 2d 400 (1st Cir. 1966), cert. dismissed 384 U. S. 935 (1966), is the first of petitioner's alleged non-accord cases (Pet. p. 13). The Court there expressed its view that file wrapper estoppel could be based upon an applicant acceding to a demand to cancel claims for reasons other than prior art. Nevertheless, the Court did accord the patentee the benefit of the doctrine of equivalents with respect to the very matter upon which the patentee, during the prosecution of the application for the patent, had introduced quantitative limitations in his claims to yield to the Examiner's rejection on indefiniteness.* From the decision, it is clear that but for so according the patentee the benefit of the doctrine of equivalents as to the angle recitations added to the claims by amendment, his claims would not have been held infringed.**

---

* This matter, introduced into the claims in response to the Examiner's position, was the recitation of angles in degrees between ports of a reversible pump, and recitation of the angle of rotation of the reversing plate.

** In the cited **Borg Warner** case, the Court of Appeals for the First Circuit considered the question whether there is a conflict, as to the applications of the doctrine of file wrapper estoppel, between cases decided by the Courts of Appeals of certain circuits as exemplified by **McCullough Tool Co. v. Well Surveys, Inc.**, 342 F. 2d 381 (10th Cir. 1965), and cases decided by certain other circuits as exemplified by **Parke, Davis & Co. v. American Cyanamid Co.**, 207 F. 2d 571 (6th Cir. 1953). These are two of the cases on which petitioner relies on pages 12 and 14 of its petition, respectively, as supporting its contention that the law is unresolved. But the Court of Appeals for the First Circuit did not find any sharp inconsistency between the laws of the different circuits. It found instead that the differences are "linguistic"—they relate more to the mode of expression than to the substance. (355 F. 2d at 405-06). A review of the cases dealt with herein, including petitioner's alleged non-accord cases,

Petitioner's next case (Pet. pp. 13-14) is *Power Curbers v. Etnyre & Co.*, 298 F. 2d 484 (4th Cir. 1962). The plaintiff's patentee Canfield originally applied for patent coverage for curb-forming machines moving on either wheels or skids. His claims as presented were to cover both arrangements. But the Examiner took the position that Canfield's disclosed machine version relying on skids would be inoperative. This position was "enthusiastically accepted, adopted and supported by the applicant, . . .", who then narrowed his claims to call for reliance upon wheels only (298 F. 2d at 495). The resulting claims narrowed to wheel coverage were held not infringed by an Etnyre curb machine using rear skids—a machine showing that the defendant Etnyre had found out how to do what the patentee Canfield had acknowledged he could not do. The doctrine of equivalents could not apply to that case, since the nonequivalence of Etnyre's machine using skids was conclusively established.

Petitioner's next case (Pet. p. 14) is *Laitram Corp. v. Deepsouth Packing Corp.*, 443 F. 2d 928 (5th Cir. 1971).* With respect to the plaintiff's shrimp slitting machine patent 2,694,218, the District Court had held that claims 1 and 3, while not literally infringed by the defendant's accused shrimp processing machine, normally would embrace that machine under the doctrine of equivalents. However, the District Court concluded that the doctrine of equivalents was unavailing to the patentee with respect to claim 1 (the first of these two claims) because of file wrapper estoppel arising from limitations inserted by

---

likewise leads to the conclusion that there is little if any inconsistency between the principles applied in the different cases, the distinctions being primarily distinctions of fact (e.g., whether or not equivalence in fact is present), rather than distinctions in underlying legal principle.

* As a result of this litigation and a related case dealing with the question whether the exporting of machine parts for assembly by customers abroad into shrimp processing machines infringes a U. S. patent, the Supreme Court granted certiorari limited to that question (92 S. Ct. 702 (1972)), and held that such acts do not infringe.

amendment. Before the Court of Appeals, Deepsouth contended that the trial court had erred in failing to hold that file wrapper estoppel similarly barred claim 3 of the '218 patent from being infringed under the doctrine of equivalents (443 F. 2d at 931-32). The Court of Appeals reached the opposite conclusion—that claim 1 as well as claim 3 should have been held infringed under the doctrine of equivalents, notwithstanding the alleged file wrapper estoppel (443 F. 2d at 934-35).

Petitioner's next case (Pet., pp. 14-15) is *Parke, Davis and Co. v. American Cyanamid Co.*, 207 F. 2d 571 (6th Cir. 1953). The District Court granted defendant Cyanamid's motion for summary judgment, holding that its medicinal product did not infringe plaintiff's patent No. 2,407,096 for anti-anemia vitamin products. The Court of Appeals affirmed, noting that after plaintiff's claims in their broader form had been rejected, it had introduced more limiting language in its claims as to how, and from what, the product was derived, thereby obtaining the allowance of the claims. The Court held that the plaintiff was thereby estopped to deny the limiting effect of the narrowed claims, this limiting effect being qualified thus:

> "The claims of the patent in suit are expressly limited to a product derived by autolysis [**or equivalent procedure**] of mammalian liver [**or similar materials**] by reason of the following claim language:
>
> 'said acid being the acid derived by autolysis of mammalian liver tissue and being free from pantothenic acid and the antipernicious anemia principle obtainable from said liver tissue, * * *.'"
>
> (207 F. 2d at 572; emphasis added).

In line with the emphasized qualifying phrases in the above-quoted passage, the reason why the accused American Cyanamid product did not infringe was not mere failure to come within the literal words of the claims, but rather, the **non-equivalence** as to the material and the procedure between that product and what was claimed by the claims

as narrowed and allowed, the Court observing, at page 573,

> "It is admitted that appellees' product is not derived from mammalian liver tissue nor from **any** animal product. It is obtained by **synthesis from discrete chemical compounds of known chemical structure by a method unrelated to the method described and originally claimed in the patent."***
>
> (Emphasis added)

The fact of the non-equivalence to what was claimed made the doctrine of equivalents inapplicable whether or not there was file wrapper estoppel.**

Petitioner's next case (Pet. p. 15) is *Keating v. Stearnes Imperial Co.*, 347 F. 2d 444 (7th Cir. 1965). Keating obtained a patent on a fast-heating oven. The oven he described was enclosed in a housing and arranged for continuous-chamber heating of its side, top and bottom walls and its rear wall (five directly heated walls). Defendant's accused product had no heating of its rear wall—it relied only on heating the sides, top and bottom, as the plaintiff-patentee Keating

---

* The defendant's product was made with different materials, using defendant's independently discovered, entirely different process on which defendant was granted its own patents (207 F. 2d at 572-73).

** In **Kolene Corp. v. Motor City Treating, Inc.**, 440 F. 2d 77, 83 (6th Cir. 1971), cert. denied 404 U. S. 886 (1971), the patent in suit claimed a nitriding process using an aerated bath comprising "between about 25 and 40% cyanate," a limitation which had been added to the claim by amendment. The defendant Motor City, which used 46 to 50% cyanate in its bath for the nitriding process, was held to infringe. The specified limits (25-40%) of the cyanate percentage range had not been relied on for patentability of the claim over the prior art, since the prior art lacked **aeration** of its cyanate bath (a 15% cyanate bath). In affirming the holding of infringement, the Sixth Circuit Court of Appeals held (1) that Motor City's process with its 46 to 50% cyanate literally infringed, and (2) that in any event, the doctrine of equivalents was available to the plaintiff Kolene, unimpaired by the file wrapper estoppel on which the defendant attempted to escape liability. This case is consistent with the Court's holding in the **Parke, Davis** case, the opposite holdings resulting from the absence of equivalence in fact in the **Parke, Davis** case and the presence of equivalence in fact in the **Kolene** case.

stipulated (347 F. 2d at 448). Keating's original application claims had been broad enough to cover generically such a four-wall heating arrangement, but had been rejected and cancelled.* As the Court observed:

> "Plaintiff's original Claim No. 1, as revealed by the file wrapper, described an oven without a continuous heating chamber. Plaintiff's original Claims Nos. 2, 3, 5, 6 and 7 described a continuous heating chamber surrounding 'at least a portion of said closed oven chamber'. Original Claims Nos. 8 and 9 referred to a 'method' of producing baked products using turbulent air. All of these claims were rejected by the Patent Office and cancelled. The claim which was allowed requires the continuous heating chamber to surround the oven chamber on five sides. Claims which might have been construed to cover less extensive heating chambers (such as the one in defendant's product) were denied."

Accordingly, the Court affirmed the District Court's holding that the resulting narrower claims were not infringed by the accused product with its four heated walls.

Ellipse Corp. v. Ford Motor Co., 452 F. 2d 163, 168 (7th Cir. 1971), cert. denied 92 S. Ct. 2041 (1972), is not inconsistent in principle with the above-discussed Seventh Circuit cases, *Keating v. Stearnes* and the *Unilectric* case. In

---

* Petitioner states that "The patentee . . . had **voluntarily** restricted his claims to narrower language." It is clear that he retrenched from his original **breadth** of claiming to **narrower** claims (unlike Spitz in the present case), but it is not clear that he did so voluntarily (i.e., independently of the Examiner's holding that the broad claims could not be allowed). A case in the Seventh Circuit which did involve the question of file wrapper estoppel based on a **voluntary** withdrawal of a broader claim is **Unilectric, Inc. v. Holwin Corp.**, 243 F. 2d 393, 398 (7th Cir. 1957), cert. denied 355 U. S. 830 (1957). There the Court rejected the file wrapper estoppel contention and affirmed the trial court's conclusion that claim 3 of the patent was infringed by the refrigerator light socket manufactured by the declaratory judgment plaintiff, by virtue of the doctrine of equivalents (243 F. 2d at 397-98). The fact that claim 4, which "for all that appears was cancelled voluntarily", was more general in character was held not to estop the patentee "from claiming its right to a reasonable range of equivalents under Claim 3." (243 F. 2d at 398).

the *Ellipse* case, claim 3 of Ellipse's Rhine patent was held infringed by a balanced slipper pump used in Ford's power steering. The pump shown and described in the patent was a balanced (symmetrical) slipper pump with an elliptical stator cavity. During the prosecution of the application the phrasing in claim 3 that the stator cavity is "elliptical" was amended to "out-of-round", which the trial court and the Court of Appeals understood in the context to mean "elliptical or equivalent." Ford unsuccessfully contended that notwithstanding Rhine's pump being shown and described with an elliptical stator cavity (which undeniably is out-of-round), the adoption of the finally chosen term "out-of-round" compelled claim 3 not to be construed in the light of Rhine's specification as meaning elliptical **or equivalent,** but rather to be construed so broadly as to encompass unbalanced slipper pumps of the prior art with their quite different stator cavity configurations. This proposition was advanced by the defendant in that case as a "file wrapper estoppel" on which to predicate its contention of invalidity. After reviewing cases on file wrapper estoppel, the Court of Appeals stated,

> "There is no file wrapper estoppel where the change in the wording was **to clarify that the stator cavity** of the Rhine pump **could merely be something more than a mathematically perfect ellipse.**
>
> "In the file wrapper Rhine refers to the limitation in the original claim that the stator be 'elliptical' as being only **'somewhat broadened'** by the added term 'out-of-round'. That reservation when considered in light of Rhine's apparent purpose in substituting 'out-of-round' sufficiently qualifies the scope of other comments in the file wrapper and limits the scope of 'out-of-round' to an 'elliptical or equivalent' stator cavity, as found by the district court. The failure to strike 'elliptical' from the specifications is one more indication that the applicant intended that term or its equivalent to define the shape of the cavity. The district court did not err in construing the scope of the amendment

to be an 'elliptical or equivalent' stator cavity."
(452 F. 2d at 168, emphasis added).

In *Bishman Mfg. Co. v. Stewart-Warner Corp.*, 380 F. 2d 336, 339-340 (7th Cir. 1967), cert. denied 389 U. S. 897 (1967) (pet., p. 11), the Court of Appeals for the Seventh Circuit stated that a necessary condition for the establishment of a file wrapper estoppel is that the patentee must have narrowed his claim in response to an objection by the Patent Office. That case involved a Hemmeter patent on an automobile wheel balancer having a fixed counterweight attached to the hub and a pair of counterweights which rotate indefinitely in opposite directions relative to the hub. The District Court's holding that claim 4 of the Hemmeter patent was valid and infringed by Stewart-Warner was affirmed. By amendments, Hemmeter's claims had been restricted to require that the counterweights be journalled to the hub in such a manner as to rotate in axially spaced planes of rotation. The Court's holding of infringement depended on the benefit of the doctrine of equivalents being accorded to Hemmeter's claim in suit since the defendant's counterweights were not journalled as stated in the claim but were **radially** spaced for rotation in the **same** plane. The Court rejected the defendant's file wrapper estoppel contention, stating:

"Furthermore, in view of these numerous recitations from the cancelled claims, it is apparent that by finally adopting the 'axially-spaced planes of rotation' language (through the amendments drafted by the defendant's patent counsel) the patentee was simply adhering to the most descriptive recitation of his structure and was not 'abandoning' part of his claim to obtain a patent. The doctrine of file wrapper estoppel is therefore inapplicable."

(380 F. 2d at 340).

Petitioner, in discussing the *Bishman* case on page 11 of its petition, fails to mention the result reached, much less bring out the fact that that result (the holding of infringement

by virtue of the doctrine of equivalents) is converse to the same Court's earlier result in *Keating v. Stearnes Imperial Co.*, 347 F. 2d 444 (*supra*, A4). The real difference is that upon considering the facts of the cases, in *Keating v. Stearnes* there was not equivalence in fact between the accused product and what was claimed in the patent as issued; in contrast, in the *Bishman* case, there was equivalence in fact between the accused product and the claim, despite the limitation inserted by amendment which prevented its literal applicability to the product. Petitioner, on page 11, diverts attention from the result reached in the *Bishman* case to *Powder Power Tool Corp. v. Powder Actuated Tool Co.*, 230 F. 2d 409 (7th Cir. 1956), wherein the Court held the patent in suit invalid and non-infringed. Petitioner argues that *Bishman* did not overrule or attempt to distinguish that earlier case. The *Bishman* case had no need to refer to that earlier case since the Court had there taken into account the whole history of prosecution of Powder Power's patent and concluded that its claim limitations which could not be met by the accused devices were indispensable limitations, and therefore had held the claims not infringed (in addition to holding them invalid).

Petitioner's next case (Pet., p. 15) is *Moon v. Cabot Shops, Inc.*, 270 F. 2d 539 (9th Cir. 1959), cert. denied 361 U. S. 965 (1960). The Court affirmed the decision below holding the Moon patent valid but not infringed, on the grounds of the trial court's holding of non-equivalence in fact—a holding which placed no reliance on file wrapper estoppel. The Court of Appeals stated, at page 545:

> "The factual finding of the trial court that the accused devices are not equivalent to the patent claims, as so construed, is not to be disturbed unless clearly erroneous. . . . We find no clear error in the making of this finding."
>
> "Although the doctrine of file wrapper estoppel was argued before the District Court, that court declined to dispose of the case on that ground. In our view it could have done so. The patentee in this case nar-

> **rowed** his claims in order to escape rejection. By thus limiting his claims, he is estopped to enlarge them by resort to the doctrine of equivalents. . . ."
>
> (Emphasis added)

This *obiter dictum* concerning file wrapper estoppel is consistent with the fact that the claims had been narrowed to the cab-straddling arrangement in view of the prior art. As the Court stated, at page 542,

> ". . . The Examiner rejected Moon's earlier claims on the ground that they were merely reversals of the prior art. When Moon clarified his claims, so that provision was made for the legs to straddle the driver's position, the claims were allowed. It would seem therefore that in the opinion of the Examiner **the straddling of the cab by the derrick legs was the crux of the invention."***
>
> (Emphasis added)

Petitioner's last case for postulating its alleged split of authorities (Pet. pp. 12 & 15) is a District Court case, *Norwood v. Ehrenreich Photo-Optical Industries, Inc., et al.*, 322 F. Supp. 898, 168 USPQ 72 (C. D. Cal., 1971). Norwood had presented, in application for his patent in suit, generic claims broad enough to cover the photographer's light meter shown in that application and the considerably different product of the defendant Ehrenreich. Ehrenreich's light meter employed two lenses and two separate photocells (light responsive units), connected together. The Patent Office rejected Norwood's broad generic claims on the ground that they would cover what Norwood himself had patented back in 1964. This ground of rejection is just as compelling as a rejection on the prior art originating from any **other** inventor. In response, Norwood narrowed his claims to make them specific to use of only a single lens and

---

* The accused derrick-truck of defendant-appellee Cabot Shops, Inc. did not have the derrick legs straddling the driver's position, but was differently arranged for the erection of a non-straddling hinged derrick at the front of the truck.

a single light-responsive means. The same narrowing Norwood was required to adopt to avoid having the claims barred by a prior patent (in that case, barred by his own prior patent) equally prevented the claims from being applicable to the accused devices. That is not parallel to the situation presented here.

This *Norwood* case, decided by a District Court in California (actually in the Ninth Circuit), is not inconsistent with the *dictum* in *Moon v. Cabot, supra,* or with the cases decided by the Tenth Circuit Court of Appeals, *Sears Roebuck & Co. v. Jones,* 308 F. 2d 705, 707-08 (10th Cir. 1962), cert. denied 371 U. S. 952 (1963); *McCullough Tool Co. v. Well Surveys, Inc.,* 343 F. 2d 381, 403 (10th Cir. 1965), cert. denied 383 U. S. 933 (1966); *Eimco Corporation v. Peterson Filters & Engineering Co.,* 406 F. 2d 431, 438 (10th Cir. 1968 & 1969), cert. denied 395 U. S. 963 (1969). In the three last-named cases, the claims having not been narrowed because of prior art, the file wrapper estoppel contention was rejected, the Court of Appeals affirming the district court holdings that the patents in suit were infringed by virtue of the doctrine of equivalents.

The above-discussed cases do not show any substantial lack of conformity to this Court's restatement of the law in *Graham v. John Deere Co.,* 383 U. S. 1, 33 (1966), quoted and relied on in *Schmidinger v. Welsh,* 383 F. 2d 455, 465 (3rd Cir. 1967), cert. denied 390 U. S. 946 (1968), that:

> "Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent."

While some courts have on occasion expressed the view that file wrapper estoppel could arise in yet other cases of claims having been narrowed, upon scrutiny, most if not all cases

in which such views have been expressed actually turned on such compelling factors as the presence or absence of equivalence in fact.*

---

*The dependence on the **facts** of equivalence or non-equivalence is demonstrable from the above discussed examples in the Sixth Circuit cases (claims in suit being held infringed under the doctrine of equivalents in the **Kolene Corp.** case, but not in the **Parke, Davis and Co.** case), and in the Seventh Circuit cases (claims in suit being held infringed under the doctrine of equivalents in the **Unilectric, Inc.** case and the **Bishman** case, but not in the **Keating** case or the **Powder Power Tool Corp.** case).

LE COPY

OCT 12 1972

IN THE

Supreme Court of the United States

October Term, 1972.

No. 72-294.

L. GOLDSTEIN'S SONS, INC.,
Petitioner,

v.

TRIO PROCESS CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

BRIEF OF RESPONDENT TRIO PROCESS CORPORATION OPPOSING MOTION OF FORD MOTOR COMPANY FOR LEAVE TO FILE A BRIEF AMICUS CURIAE.

THOMAS M. FERRILL, JR.,
Suite 106, Towle Building,
1777 Walton Rd.,
Blue Bell, Penna. 19422,
Attorney for Respondent.

Of Counsel:
ROGER NORMAN COE
ALLEN V. HAZELTINE

October 9, 1972.

Huntzinger Printing Corp., *Appellate Printers*, Camden, N. J.

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1972.

No. 72-294.

L. GOLDSTEIN'S SONS, INC.,

Petitioner,

v.

TRIO PROCESS CORPORATION,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF OF RESPONDENT TRIO PROCESS CORPORATION OPPOSING MOTION OF FORD MOTOR COMPANY FOR LEAVE TO FILE A BRIEF AMICUS CURIAE.

Ford Motor Company seeks leave to file a brief *amicus curiae* because of its involvement in a copending patent suit which, according to Ford's contentions, involves a related issue. Respondent opposes the filing of such a brief.

In *Ellipse Corporation v. Ford Motor Co.*, 452 F. 2d 163, 167-170 (7th Cir., 1970), the Court of Appeals affirmed the District Court's holding that claim 3 of Ellipse's patent number 2,628,568 to Rhine is valid and infringed by the balanced slipper pumps used in Ford's automobile power

steering system. Ford unsuccessfully petitioned for a writ of *certiorari* (—— U. S. ——, 92 S. Ct. 2041).

Ford now comes to this Court in dual postures. First, in is own case, Ford urges the Court to reconsider its denial of Ford's petition for writ of *certiorari*, again arguing "file wrapper estoppel", and urging that the present case demonstrates a need for resolution of a matter on which it repeats its contention that the different Circuit Courts of Appeals are divided. Second, Ford asks leave to interpose a brief *amicus curiae* in the present case.

Ford's motion for leave to file an *amicus* brief should be denied because: (1) Ford does not have a genuine interest in any matter at issue in the present case, and (2) an additional brief, filed in the present case without full knowledge of the factual background, is more likely to be distractive than helpful.

Ford Does Not Have a Genuine Interest In Any Matter At Issue In This Case.

The proposition which Ford urges as being identically presented in the first question of Goldstein's petition in the present case and the first question in Ford's petition in the *Ellipse* case is not properly presented for determination in either of the two cases, much less identically presented in both.

In *Ellipse v. Ford*, what the Rhine '568 patent shows and describes is a balanced slipper pump having an elliptical stator cavity (see appendix to Ford's Petition for a Writ of Certiorari in *Ford Motor Co. v. Ellipse Corp.*, No. 71-1147, filed in March, 1972, A59-A70). Ford uses such a balanced slipper pump with an elliptical stator cavity. Claim 3 of Ellipse's Rhine patent clearly is literally infringed by Ford's balanced slipper pump. Ford attempts to escape liability on the ground that when the Rhine application for the '568

patent was pending, the claim which ultimately became claim 3 of the patent was so greatly broadened by the rewording from "elliptical stator cavity" to "out-of-round stator cavity" as to render the resultant claim 3 of the patent invalid because of anticipation by certain **unbalanced** pumps with asymmetrical cavities quite different from elliptical cavities. The Seventh Circuit Court of Appeals concluded that that change of the claim wording only **slightly** broadened the scope of the claim to cover a pump with elliptical **or equivalent** stator cavity, whereby a pump with an approximately elliptical cavity would be a literal infringement. The Court of Appeals did not avoid relying on the Rhine file wrapper to determine how much the claim had been broadened—quite the contrary.* The Court did indeed consider the impact of the change of wording as introduced in the claim by amendment, as well as the remarks concerning that change. Thus, the Court noted that the Rhine file wrapper "refers to the limitation in the original claim that the stator be 'elliptical' as being only 'somewhat broadened' by the added term 'out-of-round.'" (452 F. 2d at 168).

Despite these facts, in straining to present a basis which might appear to appeal to this Court's interest in giving aid and guidance to the courts below toward uniformity of application of legal principles, Ford glosses over the fact that the Seventh Circuit Court of Appeals did indeed take into account fully Rhine's file wrapper in determining how claim 3 of Rhine's patent should be construed, and found it to be **slightly** broadened, unanticipated by the prior art, and literally infringed by Ford's balanced slipper pumps with their elliptical stator cavities. Ford had to overlook that fact,

---

* The Seventh Circuit Court of Appeals, notwithstanding its comments on the holdings of various prior cases concerning the conditions under which file wrapper estoppel arises, did not by any means rule out consideration of the changed scope of Rhine's claim, or the comments concerning it, on the ground that that change did not result from rejection of the claim on the prior art (or on any other ground).

since otherwise it hardly could have urged this Court to consider taking the position that the Court below had erred in refusing to proceed in accordance with, and be governed by, the changes of claim wording and explanatory remarks set forth in the file wrapper.*

The present case also fails to present for determination, as a controlling issue, the question whether the narrowing (or the broadening) of a claim during prosecution of the patent application for reasons other than overcoming a rejection on prior art, constitutes estoppel. In the present case there are three claims in suit (claims 1, 3 and 4), of which the first claim is literally infringed by the defendant-petitioner Goldstein's, the doctrine of equivalents being invoked for the other two claims in suit (claims 3 and 4). Goldstein's urged the Court of Appeals to deny respondent Trio the benefit of the doctrine of equivalents on the ground that a file wrapper estoppel had arisen in the prosecution of Spitz's application for the wire reclamation process patent in suit. Here, as in the *Ford* case, attention was indeed given by the Court to the file wrapper to ascertain whether it showed circumstances which would

> ". . . estop a patentee from taking a position as to the meaning of claims when asserting them during litigation inconsistent with the position he had taken before the Patent office when obtaining them?"**

---

* What this really leaves for Ford to urge upon this Court with respect to **Ellipse v. Ford**, is that the Supreme Court make itself available for one more stage of appellate review so that Ford may try to persuade this Court to take into account the Rhine file wrapper (the lower courts already having taken it into account) but somehow to come to a conclusion as to the issue of validity of claim 3 opposite to to that reached by both the Courts below on the same facts.

** This quoted portion is Ford's phrasing which appears on page 3 of its Supplemental Brief in Support of Petitioner's Petition for Rehearing of Denial of Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit, filed on or about September 22, 1972, a brief purportedly deriving justification under Supreme Court Rule 58(2) from the recent emergence of the decision in **Trio v. Goldstein's**, and urging the Court to grant writs of certiorari in both cases.

But for its lack of familiarity with all the facts of the present case, Ford might well have recognized the futility of trying to lean on this case for any help. To do so is clutching at straws. What the Court of Appeals found upon scrutiny of the Spitz file wrapper was that the Examiner, in accordance with a technical rule of the Patent Office, had refused to permit the applicant to insert in his application claims 16 and 17 (as initially worded) which the Examiner deemed to deviate in one respect from the order of steps delineated in the specification. Patent Office Rule 75(d), providing that "The claim or claims must conform to the invention as set forth in the remainder of the specification . . . ", made it incumbent on the Examiner to proceed as he did. The two claims refused on that technical rule were amended to provide unquestionable conformity to the explicitly described illustrative "embodiment" of the invention, and eventually issued as claims 3 and 4 of the patent.

The initial versions of application claims 16 and 17, which were not includable according to the Patent Office's technical rule, were not anticipated by the prior art. Neither were they narrowed down (or broadened) to meet definiteness requirements. They were refused only because the doctrine of equivalents, which does come into effect in an infringement suit to defeat piracy by others, does not confer upon an applicant the right to insert claims specific to obvious equivalents to the embodiment he describes in his specification—equivalents which would infringe in any event under the doctrine. *In re Key*, 76 F. 2d 398, 400 (C. C. P. A., 1935); *Bryson v. Clarke*, 92 F. 2d 720, 724-25 (C. C. P. A., 1937).

In the litigation against petitioner Goldstein's, Spitz thus takes no position as to the meaning of even claims 3 and 4 of his patent which would be, in Ford's words, ". . . inconsistent with the position he had taken before the Patent Office when obtaining them." He takes the same position in the litigation as he took then—that (1) he must comply

with the Patent Office's technical rules, and (2) under the applicable law, he would be entitled to the protection afforded by his patent claims, against a process which is a literal infringement of any claim whose terms are met (claim 1), and against a process which, if not a literal infringement of certain claims (claims 3 and 4), employs substantially the same combination of steps in substantially the same way to produce the same results. There is no way to reshape the Patent Office's enforcement of its rule 75(d) into a commitment in advance by the applicant that his patent shall be deprived of the law's normal protection afforded patentees under the doctrine of equivalents.

An Additional Brief by a Non-Party Lacking Thorough Familiarity with This Case Would be Distractive—Not Helpful.

What the movant Ford proposes to argue in an *amicus curiae* brief is that this case presents for resolution an unsettled question troubling the Circuit Courts of Appeals. But as shown above, the question posed by Ford really is not presented for determination in this case. Furthermore, the attempts to show diversity of views on the conditions for file wrapper estoppel among the various Circuit Courts of Appeals depend mainly on *obiter dictum*, rather than any showing of cases where application of different rules of law produced irreconcilable results. In *Borg-Warner Corp. v. Paragon Gear Works, Inc.*, 355 F. 2d 400, 405-06 (1st Cir., 1965), cert. dismissed 384 U. S. 935 (1966), the First Circuit Court of Appeals compared cases containing statements to the effect that the presence or absence of a rejection on prior art is a criterion for file wrapper estoppel with other cases which seem to differ as to the criteria, and concluded that in reality, the cases do not show substantial variation.

As the Court there observed, "Actually, we believe there is no real conflict, except linguistic."

The greatest variations among the cases which refer to "file wrapper estoppel", or deal with related principles, are the variations in the facts presented. In the last analysis, each case must be decided on its facts. And when the facts as well as the Court's conclusions are taken into account, one finds substantial consistency among the applications of the principle of file wrapper estoppel, not only within a given circuit but among the different circuits. Respondent Trio submits that Ford's attempted injection of itself into this case to urge a contrary view to try to benefit its own case is neither needed nor justified, and hence its motion should be denied.

Respectfully submitted,

THOMAS M. FERRILL, JR.,
Attorney for Respondent.

Of Counsel:
ROGER NORMAN COE
ALLEN V. HAZELTINE

FILE COPY

NOV 3 1972

IN THE

Supreme Court of the United States

October Term, 1972.

No. 72-294.

L. GOLDSTEIN'S SONS, INC.,
Petitioner,

v.

TRIO PROCESS CORPORATION,
Respondent.

PETITIONER'S REPLY BRIEF TO RESPONDENT'S BRIEF IN OPPOSITION.

HERBERT A. FOGEL,
DAVID F. MAXWELL,
OBERMAYER, REBMANN, MAXWELL & HIPPEL,
14th Floor, Packard Building,
Philadelphia, Pennsylvania. 19102

NELSON E. KIMMELMAN,
1407 Lewis Tower Building,
Philadelphia, Pennsylvania. 19102

HENRY N. PAUL, JR.,
WALLACE D. NEWCOMB,
PAUL & PAUL,
1815 Land Title Building,
Philadelphia, Pennsylvania. 19110
Attorneys for Petitioner,
L. Goldstein's Sons, Inc.

International, 711 So. 50th St., Phila., Pa. 19143—Tel. SA 7-8711 Area Code 215

INDEX.

	Page
There Is a Clear and Direct Conflict in the Federal Courts as to Restoration of Rejected and Abandoned Patent Claims	1
There Is No Literal Infringement of Any of the Claims in the Present Case and No Holding to Such Effect	3
The Statutory Presumption of Validity Is Not Applicable to Claims Rejected by the Patent Office, Abandoned by the Patentee and Later Sought to Be Restored by Construction of the Claims as Allowed	5
Conclusion	7

TABLE OF CASES CITED.

	Page
Borg-Warner Corporation v. Paragon Gear Works, Inc., 355 F. 2d 400 (C. A. 1, 1965)	2
Enterprise Mfg. Co. v. Shakespeare Co., 141 F. 2d 916 (C. A. 6, 1944)	6
Schriber Co. v. Cleveland Trust Co., 311 U. S. 211 (1940)	1
Trio Process Corporation v. L. Goldstein's Sons, Inc., 461 F. 2d 66 (C. A. 3, 1972)	2, 3

THERE IS A CLEAR AND DIRECT CONFLICT IN THE FEDERAL COURTS AS TO RESTORATION OF REJECTED AND ABANDONED PATENT CLAIMS.

In its Brief in Opposition (p. 7) Respondent takes the position that "This case presents nothing more than the application of well settled principles . . .". We submit that the principles relating to the field of patent file wrapper estoppel are far from well settled in view of the departure of a minority of the Courts of Appeals from the principles established by the United States Supreme Court.

The principles applicable to file wrapper estoppel were set forth by this Court over thirty years ago in the following language:

> "Where the patentee in the course of his application in the patent office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed." *Schriber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 218 (1940).

In spite of this clear statement of the law, the Court of Appeals in the present case revived and restored to the patent in suit claims which the patentee had amended, cancelled and abandoned. In doing so, it joined a minority of the Courts of Appeals which has created an exception to the Supreme Court rule of *Schriber*, an exception which has all but emasculated the rule. The conflict between the Supreme Court and the majority on the one hand and the minority on the other is clear and obvious from a direct comparison of the published opinions relating to the application of the rule of file wrapper estoppel:

Majority	*Minority*
"If an applicant who accedes to a demand based on the prior art is thereafter estopped to contest its necessity, he should equally be estopped to deny the correctness of a demand for which some other reason is given." *Borg-Warner Corporation v. Paragon Gear Works, Inc.*, 355 F. 2d 400, 406 (C. A. 1, 1965)	"By redrafting or abandoning a claim in the face of a prior art rejection, the patentee is conceding that he has not invented what he thereby disclaims, and therefore will not be heard to assert, at a later date, what he disclaimed as his invention. Accordingly, for 'file-wrapper estoppel' to become operable, it is necessary, at the least, that a claim have been narrowed to avoid the prior art." *Trio Process Corporation v. L. Goldstein's Sons, Inc.*, 461 F. 2d 66, 75 (C. A. 3, 1972)

It will thus be seen that the application of the *Schriber* principle is far from well settled. The plain fact is that there is such confusion and conflict between the Courts of Appeals in this important phase of patent law as to introduce a serious element of unpredictability. In the uncertainty now existing in the various Courts of Appeals the only thing well settled in this troubled field is that there is conflict and disagreement as to the application of the principle of file wrapper estoppel in patent cases. The present case illustrates the dangers inherent in permitting such direct conflicts to continue. Patent claims which would be held not infringed in at least six of the Federal Circuits are somehow willfully infringed in the Third Circuit. Patent infringement or non-infringement thus turns on acci-

dents of geography and a defendant may unwittingly become a willful infringer. Surely, conflicts between the Courts of Appeals leading to anomalous results such as this should be resolved by the United States Supreme Court in the interest of justice, uniformity and in protection of the public interest for, in the end, it is the public that suffers when the law is uncertain and particularly in the field of patent infringement where "the known certainty of the law" should operate to protect the public.

THERE IS NO LITERAL INFRINGEMENT OF ANY OF THE CLAIMS IN THE PRESENT CASE AND NO HOLDING TO SUCH EFFECT.

In its Brief in Opposition (p. 8), Respondent asserts that the finding of the Court of Appeals as to infringement, while based on the application of the doctrine of equivalents, could have been based on a finding of literal infringement. The fatal defect in this argument is that the Court of Appeals not only reached its conclusion on infringement by application of the doctrine of equivalents but recognized the necessity of relying upon the doctrine of equivalents. The Court of Appeals stated its position and also Respondent's position as follows:

> "Trio asserts that it is immaterial whether the pile is ignited before or after superimposition of the furnace, *and that the conclusion of the district court is therefore correct under* the doctrine of equivalents."* *Trio Process Corporation v. L. Goldstein's Sons, Inc.*, 461 F. 2d 66, 74 (C. A. 3, 1972)

By way of confirming that it was basing its finding of infringement on application of the doctrine of equivalents, the Court said:

> "*Unless Trio is barred from asserting the doctrine of equivalents** because of 'file wrapper estoppel', the conclusion that the patent was infringed must be affirmed." (*supra* p. 75)

Having successfully persuaded the Court of Appeals to apply the doctrine of equivalents, Respondent now seeks to avoid inquiry by the Supreme Court into the conflict of the courts on file wrapper estoppel by turning away from its original theory to an alleged "literal infringement" theory which is completely lacking in any support either in the decision of the District Court, or in the decision of the Court of Appeals, or in the facts of the case. Indeed, according to the inventor's testimony, claim 1, like claims 3 and 4, recites a series of steps in the sequence in which they are intended to be performed. Petitioner's process admittedly does not employ this sequence. It would seem that Respondent should support the theory which it urged below and which the Court of Appeals adopted, rather than to now suggest that the Court might have acted on an entirely different theory. At all events, Respondent's abandonment of the theory relied upon by it and the Court of Appeals can have no bearing on the question now before this Court on the present petition since the question here is whether the Court of Appeals erred in its application of the doctrine of equivalents, not whether it might have applied some other theory. We contend the Court was in error and that its decision should be reversed.

---

* Emphasis added

THE STATUTORY PRESUMPTION OF VALIDITY IS NOT APPLICABLE TO CLAIMS REJECTED BY THE PATENT OFFICE, ABANDONED BY THE PATENTEE AND LATER SOUGHT TO BE RESTORED BY CONSTRUCTION OF THE CLAIMS AS ALLOWED.

Respondent in its Brief in Opposition and the Court of Appeals in its opinion rely heavily on the proposition that the statutory presumption of validity has not been overcome in the present case. In doing so, both Respondent and the Court of Appeals have failed to recognize the fact that the Patent Office consistently rejected claims corresponding to the claims as restored by construction by the Court of Appeals. The presumption of validity extends no further than the claims as the Patent Office allowed them in the issued patent. In fact, the presumption should be the other way as to claims rejected by the Patent Office and abandoned by the patentee. Surely, Congress did not intend that this section of the Patent Statute would empower a court to construe allowed patent claims in such manner as to restore matter that has been rejected and abandoned and at the same time hold that claims thus restored are presumptively valid.

We submit there is grave error in the present case in applying the statutory presumption of validity to patent claims which the Court has expanded by construction to encompass what the Patent Office held, and the inventor by narrowing his claims has conceded, to be unpatentable. Legislation which was designed to support the Patent Office as to the validity of claims issued by it is being used in the present case to overturn the Patent Office holding as to what was not patentable.

In view of all of the circumstances of this case, the finding of willful infringement as a matter of law is clearly in error for the following reasons:

1. Petitioner consulted patent counsel before proceeding and was advised that the prior art stood in the way of patentability.

2. The District Court concurred in this opinion of invalidity.

3. The Court of Appeals found infringement only by applying an incorrect view as to the application of the doctrine of equivalents and file wrapper estoppel in a field where even the courts are in sharp disagreement.

4. What the Patent Office rejected and plaintiff cancelled, the Court of Appeals has now, by construction, erroneously restored. As a matter of law and common sense, it would seem to be impossible to infringe willfully claims thus construed to cover rejected and abandoned subject matter.

5. The District Court's finding of willful infringement as a conclusion of law, coupled as it was, with a finding of patent invalidity was in error because it is not possible to infringe an invalid patent claim either willfully or otherwise.

6. Where a holding of patent infringement is unpredictable, the element of willfullness is not supplied by contesting validity.

As stated by the Court of Appeals for the Sixth Circuit in *Enterprise Mfg. Co. v. Shakespeare Co.*, 141 F. 2d 916, 920 (C. A. 6, 1944):

> "To question the validity of a patent does not, of itself, constitute wilful infringement."

In the present case Petitioner successfully contested validity of the patent in the District Court. It was not until the

Court of Appeals by construction restored the rejected and abandoned claims and held them presumptively valid that any basis existed for a holding of infringement. We submit it is error to characterize such an unpredictable "infringement" as willful.

CONCLUSION.

The Court of Appeals decision in the present case is in conflict with a majority of the other Federal Courts of Appeals and with this Court. It is also in error in its conclusions of law as regards patent validity, infringement and willfullness. To resolve these conflicts and to correct these errors, the Petition for Writ of Certiorari should be granted.

Respectfully submitted,

HERBERT A. FOGEL,
DAVID F. MAXWELL,
OBERMAYER, REBMANN, MAXWELL & HIPPEL,
14th Floor, Packard Building,
Philadelphia, Pennsylvania. 19102

NELSON E. KIMMELMAN,
1407 Lewis Tower Building,
Philadelphia, Pennsylvania. 19102

HENRY N. PAUL, JR.,
WALLACE D. NEWCOMB,
PAUL & PAUL,
1815 Land Title Building,
Philadelphia, Pennsylvania. 19110
Attorneys for Petitioner,
L. Goldstein's Sons, Inc.